



Corr
MACH2/CON

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patentees : Bernard F. Mach et al.
Patent No. : 6,818,393 B1
Issued : November 16, 2004
On Application No. : 08/484,786 Confirmation No. : 4894
Filed : June 7, 1995
For : DNA SEQUENCES CODING FOR THE DR BETA-
CHAIN LOCUS OF THE HUMAN LYMPHOCYTE
ANTIGEN COMPLEX AND POLYPEPTIDES,
DIAGNOSTIC TYPING PROCESSES AND
PRODUCTS RELATED THERETO
Group Art Unit : 1634
Examiner : Jehanne Souaya Sitton

01/27/2005 MGEBREM2 00000123 6818393

01 FC:1811

100.00 OP

New York, New York
January 24, 2005

**Certificate
FEB 03 2005
of Correction**

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REQUEST UNDER 37 C.F.R. § 1.323
FOR CERTIFICATE OF CORRECTION

Sir:

This is to request a Certificate of Correction under 37 C.F.R. § 1.323 in the above-identified patent. Under 35 U.S.C. § 255, such a Certificate is available for the correction of errors of a typographical or clerical character, provided that the correction does not involve

FEB 03 2005

changes that would constitute new matter or require reexamination. Patentees have enclosed Form PTO-1050 (in duplicate) listing two errors that have been found in the above-identified patent. These errors are believed to be the responsibility of the patentees.

First, the Assignee information printed on the front page of the issued patent should read "bioMérieux S.A." instead of "bioMirieux sa". Patentees believe that this error is of a typographical or clerical nature and does not constitute new matter or require reexamination.

Second, patentees request correction of an inadvertent typographical or clerical error in the Terminal Disclaimer submitted on April 6, 2004 (copy attached at Tab A). This Terminal Disclaimer was filed to obviate a non-statutory double patenting rejection over parent Application No. 07/902,999, filed June 23, 1992, now U.S. Patent 5,503,976 ("the '976 patent"), issued April 2, 1996. As a patent issued after June 8, 1995 on an application pending on June 8, 1995, the '976 patent is entitled to a term which expires on the later of 17 years from its issue date or 20 years from its filing date. In this case, April 2, 2013 (17 years from the issue date) is the expiration date of the parent '976 patent.

Patentees request this correction to the Terminal Disclaimer filed in U.S. Patent 6,818,393 ("the '393 patent") because it contains an ambiguity with regard to the date beyond which the term of the '393 patent is disclaimed. The Terminal Disclaimer clearly describes this date as the expiration date of the full statutory term of the parent '976 patent. In particular, the second paragraph on page 2 states:

“The undersigned, on behalf of BIOMERIEUX, hereby disclaims the terminal portion of any patent granted on the above-identified ‘786 application, which would extend beyond **the expiration date of the full statutory term of the ‘976 patent**” (emphasis added).

In the first full paragraph on page 3, the Terminal Disclaimer further specifies that

“[t]he undersigned, on behalf of BIOMERIEUX, does not disclaim any terminal portion of any patent granted on the above-identified ‘786 application prior to December 8, 2009, **the expiration of the full statutory term of the ‘976 patent**” (emphasis added).

At the same time, the Terminal Disclaimer erroneously identifies the calendar date of the expiration of the full statutory term of the ‘976 patent as December 8, 2009 instead of April 2, 2013 (see page 3, line 9). The Terminal Disclaimer, therefore, misidentifies the calendar date beyond which the term of the ‘393 patent is disclaimed. To correct the resulting ambiguity, patentees request correction of page 3, line 9 of the Terminal Disclaimer to replace “December 8, 2009” with “April 2, 2013”.

As the Declaration of Margaret A. Pierri, attached at Tab B, demonstrates, the ambiguity described above is due to a typographical or clerical error that occurred during the preparation of the Terminal Disclaimer. Specifically, the attorney who drafted the Terminal Disclaimer used as a template a terminal disclaimer that she had previously drafted for a related application in the same patent family. In the template terminal disclaimer, the date beyond which the patent term was being disclaimed was the expiration date of related U.S. Patent No. 5,169,941, December 8, 2009. The attorney copied the template terminal disclaimer and revised

the number of the patent involved. However, she inadvertently neglected to revise the relevant expiration date. Consequently, the Terminal Disclaimer as filed mistakenly states that the calendar date of the expiration of the '976 patent is December 8, 2009.

Federal Circuit case law supports the correction of an ambiguous terminal disclaimer. In particular, the Federal Circuit has held that correction of PTO records is appropriate where a terminal disclaimer refers to two different expiration dates. See Bayer AG v. Carlsbad Tech., Inc., 298 F.3d 1377, 64 U.S.P.Q.2d 1045 (Fed. Cir. 2002) ("Bayer", attached at Tab C). In Bayer, a terminal disclaimer indicated interdependence between related patents in addition to reciting a specific expiration date. As a result, the Federal Circuit held that the disclaimed term was "due to" the patent referred to, rather than independent of it. Id. at 1382. The Federal Circuit also held that the public had not been prejudiced by the correction, noting that the patentee had acted promptly to rectify the ambiguity. Id.

Here, as in Bayer, the Terminal Disclaimer is ambiguous because it refers to two different expiration dates, "the expiration date of the full statutory term of the '976 patent" (i.e., April 2, 2013), and a specific calendar date, "December 8, 2009". Like the terminal disclaimer in Bayer, patentee's Terminal Disclaimer clearly indicates interdependence between the '393 and '976 patents, disclaiming the portion of the term "which would extend beyond the expiration date of the full statutory term of the '976 patent" (see page 2, second paragraph) and stating that any portion of the term prior to "the expiration of the full statutory term of the '976 patent" is not disclaimed (see page 3, first full paragraph). Thus, correction of the Terminal Disclaimer to

replace an erroneous calendar expiration date, December 8, 2009, with the correct expiration date of the ‘976 patent, April 2, 2013, is in keeping with Bayer. In addition, as in Bayer, the correction of the Terminal Disclaimer will not prejudice the public. The Terminal Disclaimer clearly refers to “the expiration date of the full statutory term of the ‘976 patent”. Furthermore, patentees are filing this Request before the public receives notice of the Terminal Disclaimer in the Official Gazette. For these reasons, the Bayer decision supports correction of the Terminal Disclaimer.

Various decisions of the Commissioner for Patents regarding requests to correct terminal disclaimers have been made available to the public on the USPTO website. Although some of these decisions have denied requests to correct terminal disclaimers, the facts of each of these cases differ significantly from those here. See In re Patent No. 4,818,816, Paper No. 45 (“Petitou”; attached at Tab D); In re Patent No. 4,346,116, Paper No. 25 (“Verwaerde”; attached at Tab E); In re Application of David L. Marshall, Application No. 07/096,207, Paper No. 50 (“Marshall”; attached at Tab F).

In the Petitou decision, a request to withdraw a terminal disclaimer in favor of a newly submitted terminal disclaimer was denied because it involved “a substantive redrafting of the language in the terminal disclaimer” rather than correction of a typographical or clerical error within the scope of 37 C.F.R. § 1.323 (see Petitou decision at, e.g., page 4). Here, in contrast, patentees seek only to correct a clear error in the stated expiration date of the ‘976 patent, the correction of which does not involve substantive redrafting of patentee’s Terminal Disclaimer.

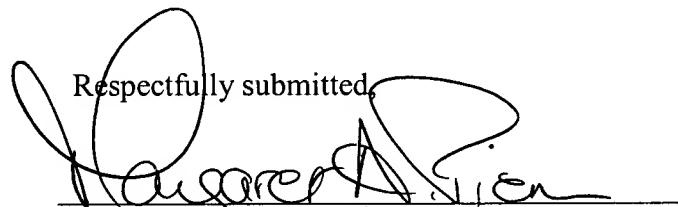
Such a correction of a typographical or clerical error (see discussion above, pages 3-4) is outside the scope of the Petitou decision.

In the Verwaerde decision, a request to withdraw a terminal disclaimer in favor of a revised terminal disclaimer was denied because “petitioners made the original terminal disclaimer absolute, that is, date-specific to July 21, 1998” (see Verwaerde decision at, e.g., page 6). The Terminal Disclaimer at issue here is distinguishable because it is not “absolute” in terms of specifying only one date. Rather, as discussed above, the Terminal Disclaimer refers repeatedly to the “full statutory term of the ‘976 patent”. Because it is plain from the face of the Terminal Disclaimer that the ‘393 and ‘976 patents are interdependent and that patentees’ reference to the date “December 8, 2009” was an error, the Verwaerde decision does not apply.

In the Marshall decision, a request to substitute a terminal disclaimer with a revised terminal disclaimer was denied where the petitioner failed to file the request with reasonable due care and diligence. Because the petitioner filed the request over three years after the terminal disclaimer had been accepted and over two years and nine months after the patent had issued, grant of the request threatened the public interest (see Marshall decision at, e.g., pages 8-9). Here, in contrast, patentees are acting promptly to correct the Terminal Disclaimer. Because patentees have filed this Request prior to publication of notice of the Terminal Disclaimer in the Official Gazette, there is no risk of detriment to the public based on reliance on the disclaimer. Thus, the Marshall decision is clearly distinguishable from the present situation.

In view of the above discussion, it is respectfully submitted that the correction to patentee's Terminal Disclaimer described above is of typographical or clerical nature, does not constitute new matter and requires no reexamination. Patentees request entry of the correction.

A check in the amount of \$100.00, in payment of the fee set forth in 37 C.F.R. § 1.20(a) is enclosed herewith. The Director is authorized to charge any additional fee required in connection with this Request to Deposit Account No. 06-1075. A duplicate copy of this Request is enclosed.

Respectfully submitted,


Margaret A. Pierr (Reg. No. 30,709)
Attorney for Patentees

c/o FISH & NEAVE IP GROUP
ROPES & GRAY LLP
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020-1105
Tel.: (212) 596-9000
Fax: (212) 596-9090

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 6,818,393 B1
DATED : November 16, 2004
INVENTORS : Bernard F. Mach et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Title page, Item (73), Assignee, replace “**bioMirieux sa**” with -- **bioMérieux S.A.** --.

Terminal Disclaimer, page 3, line 9, replace “December 8, 2009” with -- April 2, 2013 --.

MAILING ADDRESS OF SENDER:

Margaret A. Pierri
Fish & Neave IP Group
Ropes & Gray LLP
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020

PATENT NO. 6,818,393 B1

No. of additional copies: 0

Burden Hour Statement: This form is estimated to take 1.0 hour to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

FEB 03 2005

**UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION**

PATENT NO. : 6,818,393 B1
DATED : November 16, 2004
INVENTORS : Bernard F. Mach et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Title page, Item (73), Assignee, replace “bioMérieux sa” with -- bioMérieux S.A. --.

Terminal Disclaimer, page 3, line 9, replace “December 8, 2009” with -- April 2, 2013 --.

MAILING ADDRESS OF SENDER:

Margaret A. Pierri
Fish & Neave IP Group
Ropes & Gray LLP
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020

PATENT NO. 6,818,393 B1

No. of additional copies: 0

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FEB 03 2005

TAB A

7



Response Under 37 CFR 1.116
Expedited Procedure
Examining Group 1634

Docket No. MACH2/CON

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Examiner : Jehanne Souaya Sitton
Group Art Unit : 1634
Applicants : Bernard F. Mach et al.
Application No. : 08/484,786 Confirmation No.: 4894
Filed : June 7, 1995
For : DNA SEQUENCES CODING FOR THE DR- β CHAIN LOCUS OF THE HUMAN LYMPHOCYTE ANTIGEN COMPLEX AND POLYPEPTIDES, DIAGNOSTIC TYPING PROCESSES AND PRODUCTS RELATED THERETO

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Mail Stop AF

TERMINAL DISCLAIMER
PURSUANT TO 37 C.F.R. § 1.321(c)

Sir:

BIOMERIEUX SA, having its principal place of business at 69 280 Marcy L'Etoile, France (hereinafter "BIOMERIEUX"), represents that it is the assignee of record of the entire right, title and interest, by assignment, of the following:

United States patent application 08/484,786
(hereinafter "the '786 application"), filed June 7, 1995, for
"DNA SEQUENCES CODING FOR THE DR- β CHAIN LOCUS OF THE HUMAN
LYMPHOCYTE ANTIGEN COMPLEX AND POLYPEPTIDES, DIAGNOSTIC TYPING
PROCESSES AND PRODUCTS RELATED THERETO", as a continuation
application of United States patent application 07/902,999 (now
United States patent 5,503,976 - issued April 2, 1996), the
assignment for which was recorded on May 5, 1993 at Reel 6522,
Frame 0428, which was filed as a divisional application of
United States patent application 06/518,393 (now United States
patent 5,169,941 - issued on December 8, 1992) (hereinafter "the
'941 patent"), filed July 29, 1983, for "DNA SEQUENCES CODING FOR
THE DR- β CHAIN LOCUS OF THE HUMAN LYMPHOCYTE ANTIGEN COMPLEX
AND POLYPEPTIDES, DIAGNOSTIC TYPING PROCESSES AND PRODUCTS
RELATED THERETO", the assignment for which was recorded on
May 5, 1993 at Reel 6531, Frame 0122.

The undersigned, on behalf of BIOMERIEUX, hereby
disclaims the terminal portion of any patent granted on the
above-identified '786 application, which would extend beyond the
expiration date of the full statutory term of the '976 patent.

The undersigned, on behalf of BIOMERIEUX, agrees that
any patent so granted on the above-identified '786 application

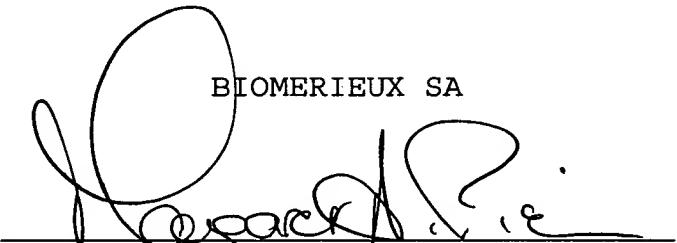
shall be enforceable only for and during such period as the legal title to said patent shall be the same as the legal title to the '976 patent, this agreement to run with any patent granted on the above-identified '786 application and to be binding upon the grantee of such patent and its successors and assigns.

The undersigned, on behalf of BIOMERIEUX, does not disclaim any terminal portion of any patent granted on the above-identified '786 application prior to December 8, 2009, the expiration of the full statutory term of the '976 patent. In the event that the '976 patent: (a) expires for failure to pay a maintenance fee, (b) is held unenforceable, (c) is found invalid, (d) is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a) or (b), (e) has all claims cancelled by a reexamination certificate, or (f) is otherwise terminated prior to expiration of its full statutory term, except for the separation of legal title stated above.

The undersigned hereby states and certifies that:

1. She is an attorney of record in the above-identified '786 application, as well as the '976 patent, and is authorized to act on behalf of assignee corporation in connection with said application; and

2. The relevant evidentiary documents have been reviewed and, to the best of the undersigned's and assignee's knowledge and belief, title in and to the above-identified '786 application, is in assignee.

BY: 
Margaret A. Pierri
Registration No. 30,709
Attorney for Applicant and Assignee
c/o FISH & NEAVE
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020
Tel.: (212) 596-9000
Fax.: (212) 596-9090

Date: April 6, 2004

TAB B



MACH2/CON

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patentees : Bernard F. Mach et al.
Patent No. : 6,818,393 B1
Issued : November 16, 2004
On Application No. : 08/484,786 Confirmation No. : 4894
Filed : June 7, 1995
For : DNA SEQUENCES CODING FOR THE DR BETA-
CHAIN LOCUS OF THE HUMAN LYMPHOCYTE
ANTIGEN COMPLEX AND POLYPEPTIDES,
DIAGNOSTIC TYPING PROCESSES AND
PRODUCTS RELATED THERETO
Group Art Unit : 1634
Examiner : Jehanne Souaya Sitton

New York, New York
January 24, 2005

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

DECLARATION OF MARGARET A. PIERRI

I, MARGARET A. PIERRI, declare that:

1. I am a partner in the Fish & Neave IP Group of Ropes & Gray LLP (formerly Fish & Neave), attorneys of record in the above-identified application. I am an

attorney of record in this application. This declaration is filed in support of patentees' Request under 37 C.F.R. § 1.323 for Certificate of Correction, submitted concurrently herewith.

2. Upon information and belief, I believe that as of at least March 17, 2003, to the present time, the system employed by employees of the Fish & Neave IP Group of Ropes & Gray to manage word processing and electronic mail documents was and is iManage infoRite ("iManage"). In iManage, the history of the work done in connection with a particular document may be viewed by selecting a tab labeled "History" at the bottom of the iManage screen. Among other things, the iManage history identifies each user of the document, each type of activity performed, and the date and time when each activity was performed.

3. I have reviewed the Terminal Disclaimer filed on April 6, 2004 in the above-identified application ("the '393 Terminal Disclaimer"). I have also reviewed the iManage histories of two iManage documents associated with the '393 Terminal Disclaimer. Based on my review of these items, I believe that the reference to "December 8, 2009" on page 3, line 9 of the '393 Terminal Disclaimer is the result of a typographical or clerical error made during the drafting of the '393 Terminal Disclaimer.

4. In April 2004, Shawn-Marie Mayrand, a former Fish & Neave associate, was the associate working on the above-identified application. Ms. Mayrand worked in the Fish & Neave Washington, D.C. office and had the relevant application files in that office. On April 5, 2004, Ms. Mayrand drafted the '393 Terminal Disclaimer in the Washington, D.C. office for my signature. On April 6, 2004, my secretary printed out the '393 Terminal Disclaimer in our New York office, so that it could be filed by our Patent Department in New York.

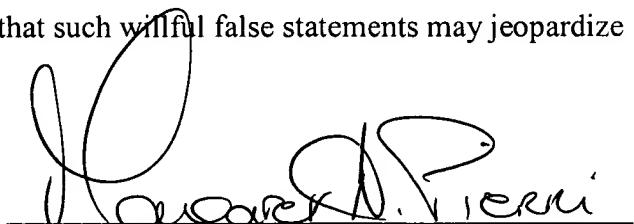
5. The iManage document number for the ‘393 Terminal Disclaimer is 20,451. A computer print-out of the complete iManage history for this document is attached as Exhibit 1. Page 3 of Exhibit 1 shows that Ms. Mayrand (indicated by the initials “SMM”) created (indicated by the word “create”) the ‘393 Terminal Disclaimer document (which was ultimately filed on April 6, 2004) on April 5, 2004 at 8:05 AM. Page 1 of Exhibit 1 shows that my secretary, Donna Prince, printed the ‘393 Terminal Disclaimer on April 6, 2004.

6. Upon information and belief, I believe that Ms. Mayrand had previously drafted a terminal disclaimer for Application No. 08/486,804, which is related to the above-identified application. Because the ‘804 application was ultimately abandoned, this related terminal disclaimer (“the ‘804 terminal disclaimer”) was never filed. A computer print-out of the draft ‘804 terminal disclaimer is attached as Exhibit 2.

7. The iManage document number for the ‘804 terminal disclaimer is 933,640. A computer print-out of the complete iManage history for this document is attached as Exhibit 3. Page 2 of Exhibit 3 shows that Ms. Mayrand (again indicated by the initials “SMM”) created the ‘804 terminal disclaimer document on March 17, 2003. Page 1 of Exhibit 3 shows that Ms. Mayrand copied the ‘804 terminal disclaimer document on April 5, 2004 at 8:05 AM. Because the date and time when Ms. Mayrand copied the ‘804 terminal disclaimer matches the date and time when the ‘393 Terminal Disclaimer was created (see paragraph 5, above), and because the text of the two documents is extremely similar, I believe that Ms. Mayrand used the ‘804 terminal disclaimer as a template for the ‘393 Terminal Disclaimer.

8. The '804 terminal disclaimer would have disclaimed the terminal portion of any patent granted that would extend beyond the calendar date of the expiration of related U.S. Patent 5,169,941 ("the '941 patent"), which is December 8, 2009 (see Exhibit 2, page 2, second paragraph and page 3, first full paragraph). Upon information and belief, I believe that after Ms. Mayrand used the '804 terminal disclaimer as a template for the '393 Terminal Disclaimer, she revised the '393 Terminal Disclaimer to refer to U.S. Patent 5,503,976 ("the '976 patent") instead of the '941 patent. Upon information and belief, I believe that Ms. Mayrand inadvertently neglected to replace the expiration date of the '941 patent, December 8, 2009, with the expiration date of the '976 patent, April 2, 2013. For these reasons, I believe that the '393 Terminal Disclaimer's reference to the date December 8, 2009, instead of the date April 2, 2013, is the result of a typographical or clerical error made during its preparation.

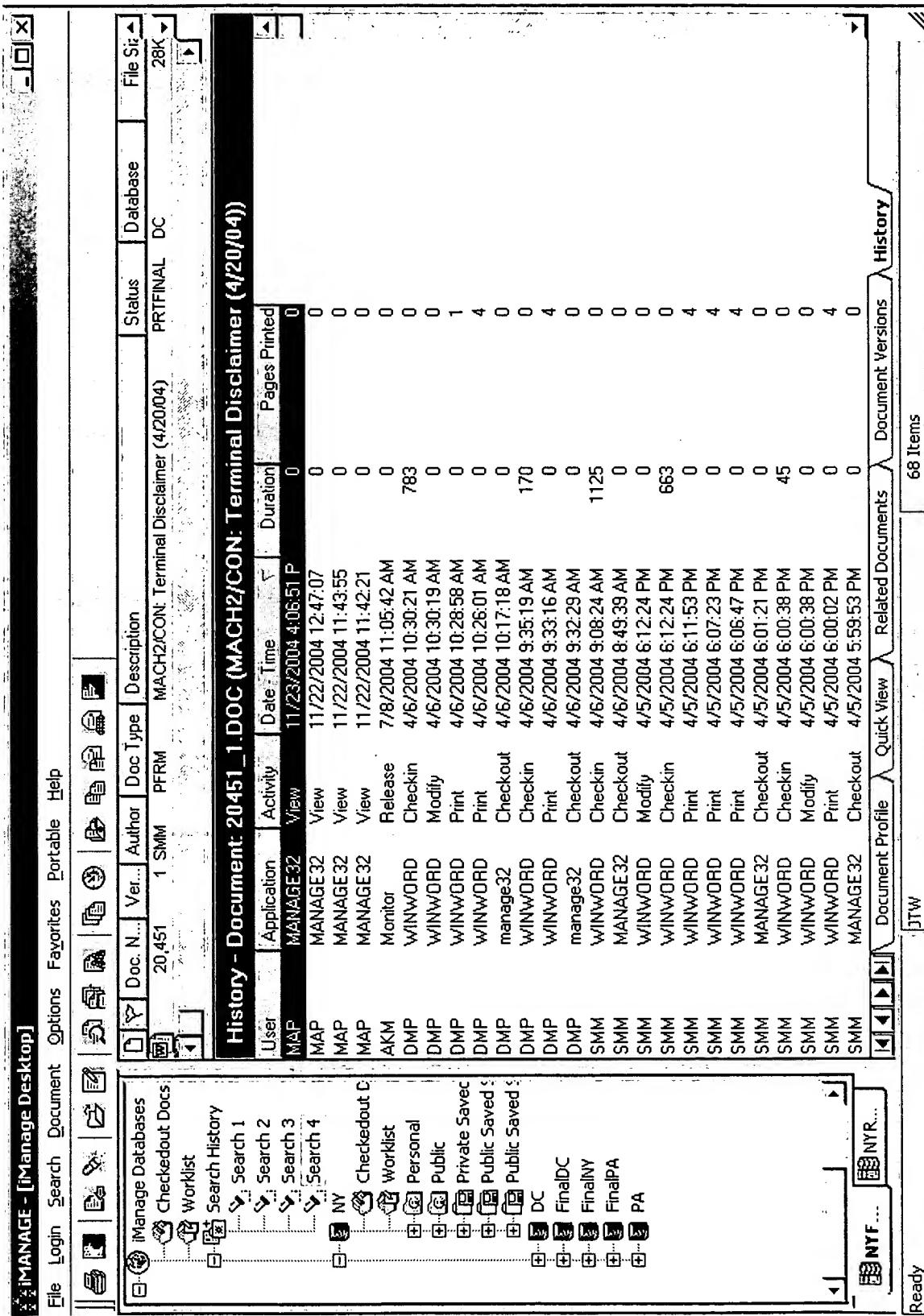
9. The undersigned declares further that all statements made herein of her own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of United States Patent 6,818,393.



Margaret A. Pierri (Reg. No. 30,709)

Signed this 24th day of January 2005
in New York, New York.

EXHIBIT 1



iMANAGE - [iManage Desktop]

File Login Search Document Options Favorites Portable Help

Manage Databases **Checkedout Docs** **Worklist** **Search History**

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NYR.... **Document Profile** **Quick View** **Related Documents** **History**

JTW **68 Items**

Ready

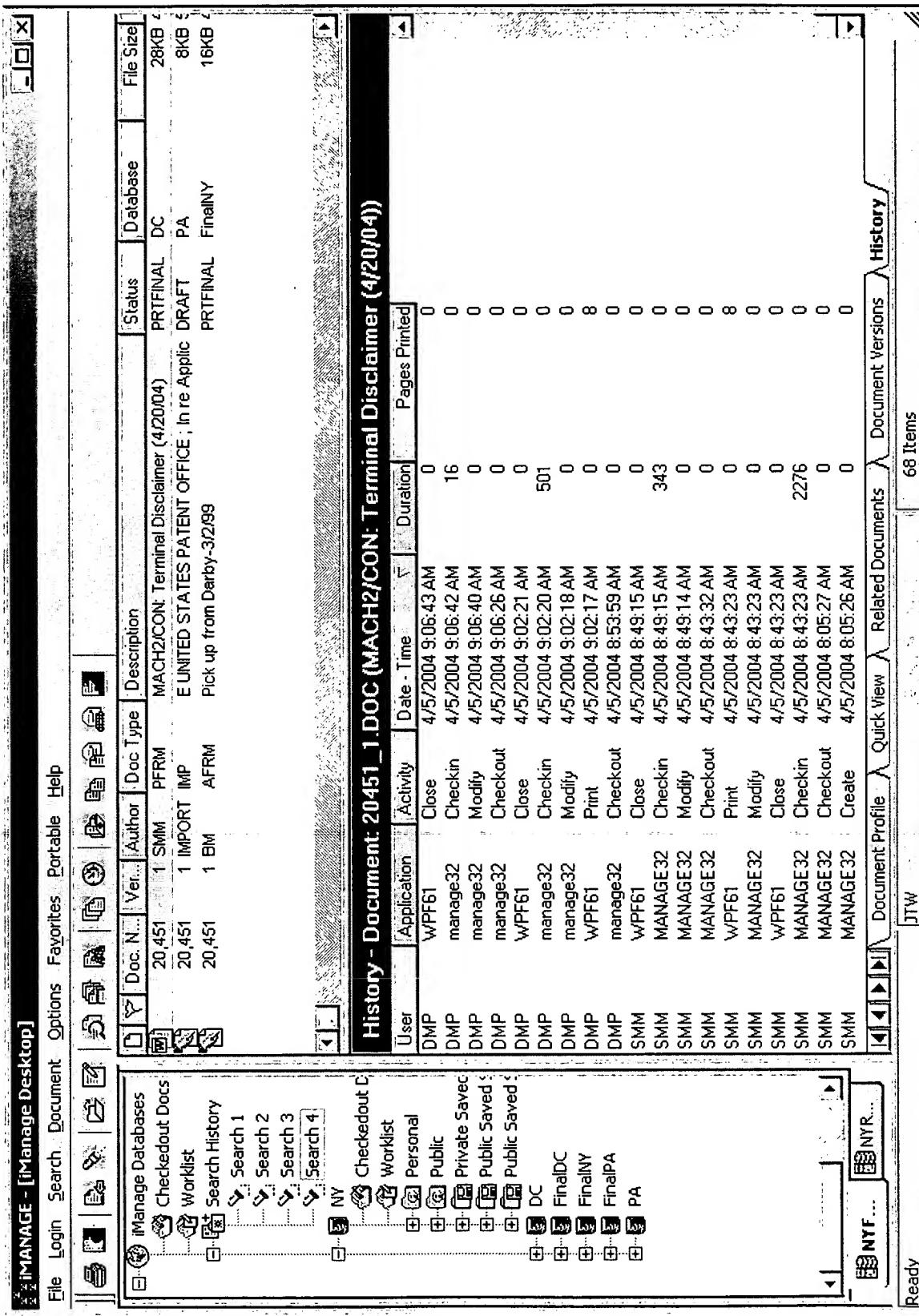


EXHIBIT 2



Docket No. MACH2/DIV2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Examiner : Ronald B. Schwadron
Group Art Unit : 1644
Applicants : Bernard F. Mach et al.
Application No. : 08/486,804 Confirmation No.: 7047
Filed : June 7, 1995
For : DNA SEQUENCES CODING FOR THE DR- β CHAIN LOCUS OF THE HUMAN LYMPHOCYTE ANTIGEN COMPLEX AND POLYPEPTIDES, DIAGNOSTIC TYPING PROCESSES AND PRODUCTS RELATED THERETO

Hon. Commissioner for Patents
P.O. Box 2327
Arlington, Virginia 22202

TERMINAL DISCLAIMER
PURSUANT TO 37 C.F.R. § 1.321(c)

Sir:

BIOMERIEUX SA, having its principal place of business at 69 280 Marcy L'Etoile, France (hereinafter "BIOMERIEUX"), represents that it is the assignee of record of the entire right, title and interest, by assignment, of the following:

United States patent application 08/486,804 (hereinafter "the '804 application"), filed June 7, 1995, for "DNA SEQUENCES CODING FOR THE DR- β CHAIN LOCUS OF THE HUMAN LYMPHOCYTE ANTIGEN COMPLEX AND POLYPEPTIDES, DIAGNOSTIC TYPING PROCESSES AND PRODUCTS RELATED THERETO", as a divisional application of United States patent application 07/902,999 (now United States patent 5,503,976 - issued April 2, 1996), the assignment for which was recorded on May 5, 1993 at Reel 6522, Frame 0428, which was filed as a divisional application of United States patent application 06/518,393 (now United States patent 5,169,941 - issued on December 8, 1992) (hereinafter "the '941 patent"), filed July 29, 1983, for "DNA SEQUENCES CODING FOR THE DR- β CHAIN LOCUS OF THE HUMAN LYMPHOCYTE ANTIGEN COMPLEX AND POLYPEPTIDES, DIAGNOSTIC TYPING PROCESSES AND PRODUCTS RELATED THERETO", the assignment for which was recorded on May 5, 1993 at Reel 6531, Frame 0122.

The undersigned, on behalf of BIOMERIEUX, hereby disclaims the terminal portion of any patent granted on the above-identified '804 application, which would extend beyond the expiration date of the full statutory term of the '941 patent.

The undersigned, on behalf of BIOMERIEUX, agrees that any patent so granted on the above-identified '804 application shall be enforceable only for and during such period as the legal title to

said patent shall be the same as the legal title to the '941 patent, this agreement to run with any patent granted on the above-identified '804 application and to be binding upon the grantee of such patent and its successors and assigns.

The undersigned, on behalf of BIOMERIEUX, does not disclaim any terminal portion of any patent granted on the above-identified '804 application prior to December 8, 2009, the expiration of the full statutory term of the '941 patent. In the event that the '941 patent: (a) expires for failure to pay a maintenance fee, (b) is held unenforceable, (c) is found invalid, (d) is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a) or (b), (e) has all claims cancelled by a reexamination certificate, or (f) is otherwise terminated prior to expiration of its full statutory term, except for the separation of legal title stated above.

The undersigned hereby states and certifies that:

1. She is an attorney of record in the above-identified '840 application, as well as the '941 patent, and is authorized to act on behalf of assignee corporation in connection with said application; and

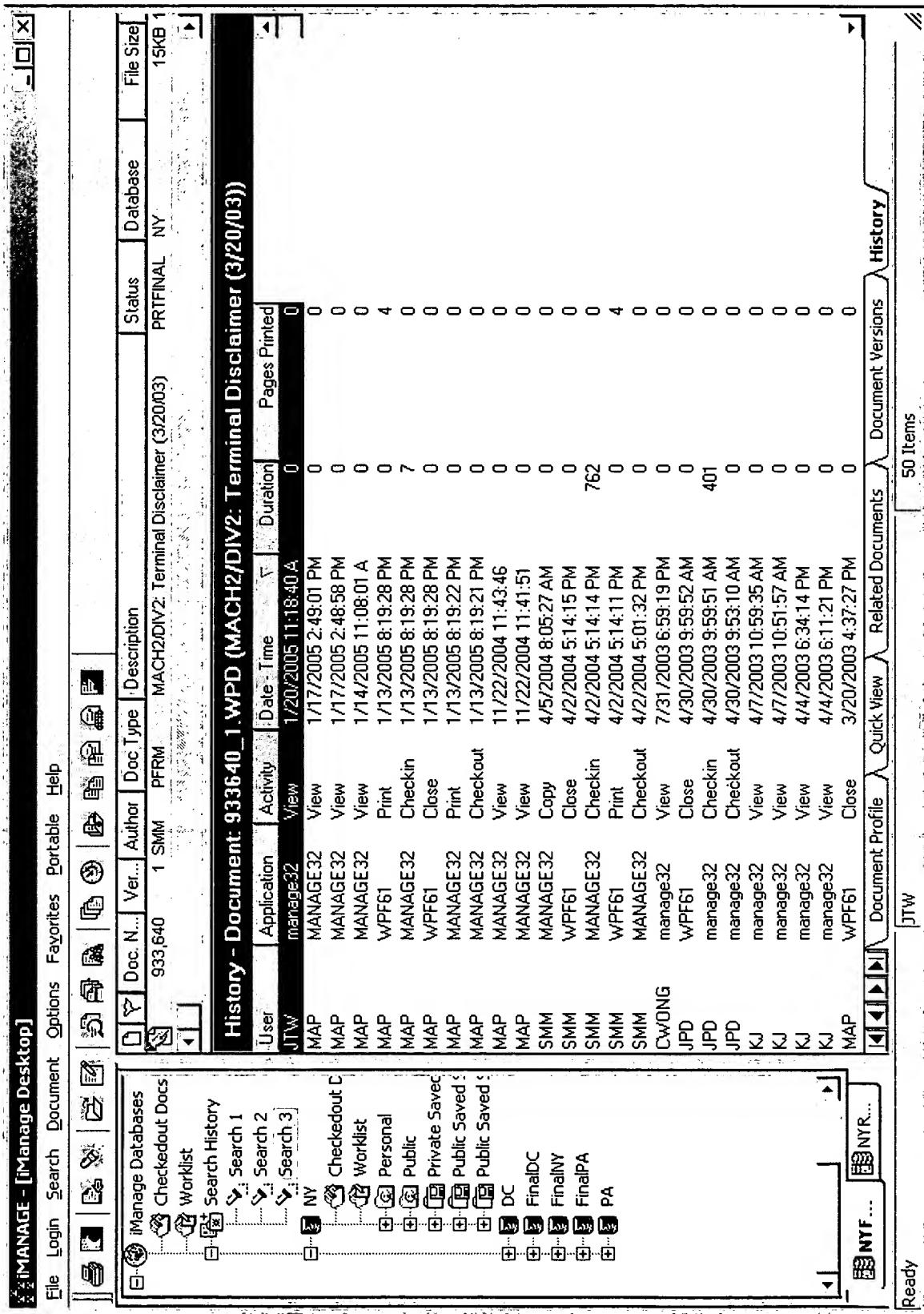
2. The relevant evidentiary documents have been reviewed and, to the best of the undersigned's and assignee's knowledge and belief, title in and to the above-identified '804 application, is in assignee.

BIOMERIEUX SA

BY: Margaret A. Pierri
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Attorney for Applicant and Assignee
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New York, New York 10020
Tel.: (212) 596-9000

Date: _____

EXHIBIT 3



MANAGE - [Manage Desktop]

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Manage Databases Checkedout Docs Worklist Search History Search 1 Search 2 Search 3 NV Checkedout C Worklist Personal Public Private Saved Public Saved Public Saved DC FinalDC FinalNY FinalPA PA NYR...

User	Application	Activity	Date - Time	Duration	Pages Printed
MAP	w/PF61	Print	3/20/2003 4:37:26 PM	0	4
MAP	manage32	Checkin	3/20/2003 4:37:26 PM	477	0
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SMM	manage32	Create	3/17/2003 5:51:13 PM	0	0

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TAB C

BAYER AG and BAYER CORPORATION, Plaintiffs-Appellees, v. CARLSBAD TECHNOLOGY, INC., Defendant-Appellant.

02-1077

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

298 F.3d 1377; 2002 U.S. App. LEXIS 16710; 64 U.S.P.Q.2D (BNA) 1045

August 14, 2002, Decided

SUBSEQUENT HISTORY: [**1] Rehearing and Rehearing En Banc Denied September 23, 2002, Reported at: *2002 U.S. App. LEXIS 21335*.

PRIOR HISTORY:Appealed from: United States District Court for the Southern District of California Senior Judge Rudi M. Brewster.

DISPOSITION: AFFIRMED.

CASE SUMMARY:

PROCEDURAL POSTURE: Plaintiff patentees sued defendant competitor, in the United States District Court for the Southern District of California, asserting that their patent on ciprofloxacin was valid until December 9, 2003. The competitor counterclaimed that the ciprofloxacin claims in the patent would expire on October 1, 2002. The parties cross-moved for summary judgment. The competitor appealed denial of its motion and summary judgment for the patentees.

OVERVIEW: The subject matter of the patent in question included the antibiotic ciprofloxacin. The patentees also obtained two related patents covering ciprofloxacin which were issued earlier in time. After another competitor asserted that the subject patent was invalid for double patenting, the patentees filed a terminal disclaimer with the United States Patent and Trademark Office (PTO). Though specifying an expiration date of October 1, 2002, the disclaimer tied termination to the earlier of the termination dates of the related patents. Subsequently, *35 U.S.C.S. § 154* was amended to extend patent terms to 20 years, thus extending the term of the earlier to expire related patent

to December 9, 2003 (20 years from filing the patent application). On this unanticipated occurrence, the patentees promptly sought to change their disclaimer to extend the expiration date, which the PTO did. The court of appeals agreed with the PTO and the district court that the amendment to § 154 automatically extended the termination date of the subject patent from October 1, 2002 to December 9, 2003. The patentees' prompt action to change the disclaimer precluded any prejudice to the competitor or the public.

OUTCOME: The court of appeals affirmed the judgment of the district court.

LexisNexis(R) Headnotes

Patent Law > U.S. Patent & Trademark Office Prosecution Procedures > Examination of Applications [HN1] See *37 C.F.R. § 1.182* (2002).

Civil Procedure > Summary Judgment > Summary Judgment Standard

[HN2] The United States Court of Appeals for the Federal Circuit reviews a district court's grant of summary judgment without deference.

Civil Procedure > Summary Judgment > Summary Judgment Standard

[HN3] In considering a motion for summary judgment, a court must decide if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. *Fed. R. Civ. P.*

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56(c). In making this determination, the court views the record in a light most favorable to the non-moving party.

Patent Law > Infringement > Exclusive Rights
[HN4] See 35 U.S.C.S. § 154(a)(2).

Patent Law > Infringement > Exclusive Rights
[HN5] See 35 U.S.C.S. § 154(c)(1).

Patent Law > Infringement > Exclusive Rights
[HN6] See 60 Fed. Reg. 20,195, 20,207 (Apr. 25, 1995).

Patent Law > U.S. Patent & Trademark Office Prosecution Procedures > Examination of Applications
[HN7] 35 U.S.C.S. § 253, which permits filing of a terminal disclaimer and "dedication to the public" of the terminal part of the term, does not include a mechanism for withdrawal or amendment of a terminal disclaimer. Under § 253, the United States Patent and Trademark Office considers the terminal disclaimer part of the original patent.

Administrative Law > Judicial Review > Standards of Review > Standards Generally

[HN8] Where an agency's interpretation of its own regulation is reasonable, it attracts substantial judicial deference.

Patent Law > Jurisdiction & Review > Standards of Review

[HN9] Federal courts are obligated by clear United States Supreme Court precedent to give deference to the United States Patent and Trademark Office's own interpretation of its regulations.

COUNSEL: Fred H. Bartlit, Jr., Bartlit Beck Herman Palenchar & Scott, of Chicago, Illinois, argued for plaintiffs-appellees. With him on the brief were Mark L. Levine and Sean W. Gallagher. Of counsel on the brief were Charles W. Bradley and Stanley L. Amberg, Orrick, Herrington & Sutcliffe LLP, of New York, New York. Also of counsel on the brief were Bruce R. Genderson, Margaret A. Keeley, and Aaron P. Maurer, Williams & Connolly LLP, of Washington, DC.

Gary M. Hnath, Venable, Baetjer, Howard & Civiletti, LLP, of Washington, DC, argued for defendant-appellant. With him on the brief was Fei-Fei Chao.

JUDGES: Before RADER, GAJARSA, and PROST, Circuit Judges.

OPINIONBY: RADER

OPINION: [*1378] RADER, Circuit Judge.

On summary judgment, the United States District Court for the Southern District of California held that the expiration date of U.S. Patent No. 4,670,444 (the '444 patent) is December 9, 2003. Because the district court correctly concluded as a matter of law that the disclaimed term of the '444 patent was "due to" U.S. Patent No. 4,544,658, whose expiration date [**2] the Uruguay Round Agreements Act (URAA) amendments automatically changed from October 1, 2002 to December 9, 2003, this court affirms.

I.

Bayer AG and Bayer Corporation (collectively Bayer) filed a patent application on May 29, 1984 that ultimately issued as the '444 patent on June 2, 1987. The subject matter of the '444 patent includes the antibiotic ciprofloxacin sold by Bayer under the brand name CIPRO (R). Bayer also obtained two related patents covering ciprofloxacin: U.S. Patent No. 4,544,658 issued on October 1, 1985 (the Peterson '658 patent) and U.S. Patent No. 4,556,658 issued on December 3, 1985 (the Grohe '658 patent).

In December 1991, Barr Laboratories, Inc. (Barr) notified Bayer of Barr's Abbreviated New Drug Application (ANDA) submission to the Food and Drug Administration (FDA). Barr alleged that the '444 patent was invalid and unenforceable due to obviousness, obviousness-type double patenting, and inequitable conduct. In response, Bayer filed an infringement suit against Barr in the United States District Court for the Southern District of New York. To counter Barr's allegation of double patenting of the '444 patent over the two '658 patents, Bayer filed a terminal [**3] disclaimer with the United States Patent and Trademark Office (PTO). *Bayer AG v. Barr Lab., Inc.*, 798 F. Supp. 196, 24 U.S.P.Q.2D (BNA) 1864 (S.D.N.Y. 1992).

On February 21, 1992, Bayer disclaimed "the terminal part of U.S. Patent No. 4,670,444 which extends beyond October 01, 2002, the earlier of the expiration dates of U.S. Patent Nos. 4,544,658 (issued October 01, 1985) and 4,556,658 (issued December 03, 1985)." Terminal Disclaimer filed February 21, 1992 (Terminal Disclaimer). This disclaimer language is the source of the present dispute. The April 21, 1992, issue of the PTO's Official Gazette carried a notice of the disclaimer stating: "The term of this patent subsequent to October 1, 2002, has been disclaimed."

In 1994, the URAA "harmonized the term provision of United States patent law with that of our leading trading partners which grant a patent term of 20 years from the date of filing of the patent application." *Merck & Co. v. Kessler*, 80 F.3d 1543, 1547, 38 U.S.P.Q.2D (BNA) 1347, 1349 (Fed. Cir. 1996). The URAA took effect on June 8, 1995, changing the patent term from

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seventeen years from the date of issuance to twenty years from the date of filing [**4] of the patent application. 35 U.S.C. § 154(a)(2) (2000). In addition, § 154(c)(1) allows "the greater of the 20-year term as provided in subsection (a), or 17 years from grant, subject to any terminal disclaimers." Id. § 154(c)(1). Consequently, the expiration date of the Peterson '658 patent changed from October 1, 2002 (seventeen years from grant) to December 9, 2003 (twenty years from filing of application) by operation of law.

[*1379] On July 10, 1995, Bayer sought to reflect the change that the URAA made on the term of the '444 patent by submitting an "amended terminal disclaimer" and a "communication submitting amended terminal disclaimer." Bayer requested the PTO amend the terminal disclaimer filed February 21, 1992 with new wording that "disclaims the terminal part . . . which would extend beyond the earlier of the expiration dates of the full statutory term . . . of U.S. Patent Nos. 4,544,658 . . . and 4,556,658" or, alternatively, to consider the communication a petition. The amended terminal disclaimer did not recite a specific date, but only referred to the expiration dates of the two '658 patents.

In view of the URAA, the PTO found Bayer's original [**5] disclaimer ambiguous in that "it sets forth two (2) dates beyond which the terminal part of the ['444 patent] is disclaimed: October 1, 2002, and December 9, 2003." Decision on petition, Application No. 06/614,923, at 5 (Jan. 31, 1996) (Decision). The PTO responded that its rules of practice did not permit withdrawal of a terminal disclaimer in favor of an amended terminal disclaimer. Nonetheless, in considering Bayer's request as a petition under its discretionary authority, * the PTO stated:

In view of the ambiguity in the terminal disclaimer filed February 21, 1992 created by the changes to 35 U.S.C. § 154(c)(1) contained in Public Law 103-465, Office records will be changed to indicate that the term of the above-identified patent subsequent to December 9, 2003, the later of the two (2) dates set forth in the terminal disclaimer filed on February 21, 1992, has been disclaimed.

Id.

* The Patent and Trademark Office (PTO) treated Bayer's communication as a petition under 37 C.F.R. § 1.182. Decision, at 1. 37 C.F.R. § 1.182 (2002) states: [HN1] "All situations not specifically provided for in the regulations of this

part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h)." [**6]

[**6]

In April 2001, Carlsbad Technology, Inc. (CTI) notified Bayer of its ANDA on ciprofloxacin. Bayer filed suit in the district court in May 2001, asserting that the '444 patent on ciprofloxacin was valid until December 9, 2003. CTI counterclaimed that the ciprofloxacin claims in the '444 patent expire on October 1, 2002. The parties dispute whether the inclusion of the "October 01, 2002" date in the February 21, 1992 terminal disclaimer created an ambiguity as to the relationship between the '444 patent and the two '658 patents. Bayer and CTI cross-moved for summary judgment. The district court denied CTI's motion and granted summary judgment in favor of Bayer. *Bayer AG v. Carlsbad Tech., Inc.*, 2001 U.S. Dist. LEXIS 24487, Civ. No. 01-867-B (LSP), slip op. at 11 (S.D. Cal. Nov. 1, 2001) (Summary Judgment). CTI timely appealed to this court, which has jurisdiction under 28 U.S.C. § 1295(a)(1).

II.

[HN2] This court reviews a district court's grant of summary judgment without deference. *Johns Hopkins Univ. v. Cellpro, Inc.*, 152 F.3d 1342, 1353, 47 U.S.P.Q.2D (BNA) 1705, 1713 (Fed. Cir. 1998). [HN3] This court must decide "if the pleadings, depositions, answers to interrogatories, and admissions [**7] on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." *Fed. R. Civ. P. 56(c)*; *Celotex Corp. v. Catrett*, 477 U.S. 317, 322, 91 L. Ed. 2d 265, 106 S. Ct. 2548 (1986). In making this determination, this court views the record in a light most favorable to the non-moving party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255, 91 L. Ed. 2d 202, 106 S. Ct. 2505 (1986); *C.R. Bard, Inc. v. Advanced Cardiovascular Sys., Inc.*, 911 F.2d 670, 672-73, 15 U.S.P.Q.2D (BNA) 1540, 1542-43 (Fed. Cir. 1990).

CTI does not dispute the facts of this case. Rather, it challenges the district court's application of the URAA to Bayer's original terminal disclaimer which upheld the PTO's determination that the '444 patent expires on December 9, 2003. CTI asserts that the 1992 disclaimer clearly and unambiguously fixed the '444 patent's expiration date to October 1, 2002. CTI notes that the

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PTO published the October 2002 date in the Gazette, indicating that the disclaimer set the expiration date for October 1, 2002.

Title 35 of the United States [**8] Code as amended in light of the URAA, states:

[HN4] (a)(2) Term. Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed.

[HN5] (c)(1) Determination. The term of a patent that is in force on or that results from an application filed before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act shall be the greater of the 20-year term as provided in subsection (a), or 17 years from grant, subject to any terminal disclaimers.

35 U.S.C. §§ 154 (a)(2) and (c)(1). In response to public comments on its rules to implement the new twenty-year term, the PTO stated:

[HN6] A patent that is in force on June 8, 1995, or a patent that issues after June 8, 1995, on an application filed before June 8, 1995, is automatically entitled to the [**9] longer of the 20-year patent term measured from the earliest U.S. effective filing date or 17 years from grant. This is automatic by operation of law. Patentees need not make any election to be entitled to the longer term.

Changes to Implement 20-year Patent Term and Provisional Applications, *60 Fed. Reg. 20,195, 20,207* (April 25, 1995) (emphasis added).

In the present case, Bayer's February 21, 1992 terminal disclaimer recites in pertinent part:

Bayer . . . disclaims the terminal part of U.S. Patent No. 4,670,444 which extends beyond October 01, 2002, the earlier of the expiration dates of U.S. Patent Nos. 4,544,658 (issued October 01, 1985) and 4,556,658 (issued December 03, 1985), and hereby agrees that U.S. Patent No. 4,670,444 shall be enforceable only for and during such period that legal title to U.S. Patent No. 4,670,444 shall be the same as legal title to U.S. Patent Nos. 4,544,658 and 4,556,658.

(Emphases added.) This disclaimer expressly sets the expiration date of the '444 patent at the "earlier of the expiration dates" of the two '658 patents. Before the URAA amendments took effect on June 8, 1995, the earlier of the [**10] expiration dates of the two '658 patents was October 1, 2002, i.e., seventeen years from date of issuance of the Peterson '658 patent. Hence, when filed in 1992, the language of the terminal disclaimer set the expiration date for the '444 patent for October 2002.

[*1381] When the URAA amendments took effect on June 8, 1995, however, the earlier of the two expiration dates became December 9, 2003, i.e., twenty years from the date of filing of the Peterson '658 patent. *35 U.S.C. § 154(a)(2)*. This extension of patent term on the Peterson '658 patent was "automatic by operation of law." *60 Fed. Reg. at 20,207*. Consequently, the terminal disclaimer of the '444 patent, as tied to the Peterson '658 patent, moved the expiration date of the '444 patent automatically to December 9, 2003. The disclaimer also mentioned the October 2002 date. In that situation, the PTO detected an ambiguity because the disclaimer now contained two dates: October 1, 2002 and December 9, 2003. The district court correctly relied on the PTO's analysis of the law and of the language of the original terminal disclaimer.

Although finding that the URAA amendments created an ambiguity [**11] in Bayer's original terminal disclaimer, the PTO declined Bayer's request to withdraw the original disclaimer and substitute a new one. The PTO explained that the rules of practice did not provide for the withdrawal of a terminal disclaimer. Decision, at 3. [HN7] Section 253, which permits filing of a terminal disclaimer and "dedication to the public" of the terminal part of the term, does not include a mechanism for withdrawal or amendment of a terminal disclaimer. *35 U.S.C. § 253*. Under *35 U.S.C. § 253*, the PTO considers the terminal disclaimer part of the original patent. The PTO also noted that the clarification of the claimed date was not the correction of a clerical

or typographical mistake under 35 U.S.C. § 255 and 37 C.F.R. § 1.323. Decision, at 2-3.

Nonetheless, because 35 U.S.C. § 154(a)(2) automatically extended the term of the Peterson '658 patent by operation of law, 60 Fed. Reg. at 20,207, the PTO corrected its records to indicate that Bayer had disclaimed the term of the '444 patent beyond December 9, 2003 in accordance with [**12] 35 U.S.C. § 154(c)(1). Decision, at 6. The district court correctly sustained the PTO's actions as a proper exercise of its authority under 37 C.F.R. § 1.182.

The district court properly accorded deference to the PTO's implementing regulations and to the PTO's interpretative "Decision", which it found complied with 35 U.S.C. §§ 154 (a)(2) and (c)(1), in accordance with *Skidmore v. Swift & Co.*, 323 U.S. 134, 140, 89 L. Ed. 124, 65 S. Ct. 161 (1944). See also *Merck*, 80 F.3d at 1550; *United States v. Cleveland Indians Baseball Co.*, 532 U.S. 200, 220, 149 L. Ed. 2d 401, 121 S. Ct. 1433 (2001) [HN8] ("Because [the agency's] interpretation [of its own regulation] is reasonable, it attracts substantial judicial deference."); *Dethmers Mfg. v. Automatic Equip. Mfg.*, 272 F.3d 1365, 1379, 60 U.S.P.Q.2D (BNA) 1929, 1939 (Fed. Cir. 2001) (Dyk, J., concurring-in-part and dissenting-in-part) [HN9] ("We are obligated by clear Supreme Court precedent to give deference to the PTO's own interpretation of its regulations."). The PTO thoroughly considered the effect of the URAA on this terminal disclaimer and gave persuasive reasons for correcting [**13] its records to reflect the December 2003 expiration date for the '444 patent.

Beyond deference to the PTO analysis, the district court also examined the meaning and effect of the URAA. As noted, the URAA states that the "term of a patent . . . shall be the greater of the 20-year term as provided in subsection (a), or 17 years from grant." 35 U.S.C. § 154(c)(1) (2000). This language mandates the automatic substitution of a later expiration date for the prior expiration date of the Peterson '658 patent. Because Bayer linked its terminal disclaimer to the expiration date of the Peterson '658 patent, the terminal disclaimer date also automatically shifted to December 2003.

[*1382] As the district court noted, the Senate Report on the URAA confirms this meaning of the statutory language as applied to terminal disclaimers:

A patent whose term has been under section 235 of Title 35 due to another patent on an invention that is not patentably distinct from but was owned by or subject to an obligation of assignment to the same person shall expire on the date of the other patent. A

patent whose term has been disclaimed under section 235 independent of another [**14] patent shall be reduced by the length of the originally disclaimed period.

Summary Judgment, at 4-5 (quoting S. Rep. No. 103-412, at 229 (1994)) (emphases added). Applying this explanation of the statutory language, the district court found: "Bayer used language indicating interdependence between several patents." Id. For example, the disclaimer recites "the earlier of the expiration dates of . . ." which modifies the date by its source. Id. The disclaimer also states that Bayer "agrees" that the '444 patent "shall be enforceable only for and during such period that legal title to U.S. Patent No. 4,670,444 shall be the same as legal title to U.S. Patent Nos. 4,544,658 and 4,556,658." Id. at 10. Accordingly, the court concluded that the disclaimed term of the '444 patent was "due to" the Peterson '658 patent, rather than "independent of" that patent. Id. This court discerns no error in the trial court's conclusion.

CTI argues that the trial court should have resolved any ambiguity in the terminal disclaimer in favor of the public. CTI argues that Bayer renounced its rights in the '444 patent after October 1, 2002, and thereby dedicated part of the term of [**15] that patent to the public. According to CTI, the public was entitled to rely on Bayer's disclaimer.

Bayer's original terminal disclaimer recited the October 1, 2002 date as a correct application of the law then in effect. When the URAA altered patent terms, Bayer acted in a timely manner to rectify any ambiguity. Bayer petitioned the PTO to withdraw the disclaimer within one month of the adoption of the URAA amendments. Moreover, the PTO's decision on Bayer's petition became part of the public record on January 31, 1996, more than five years before CTI filed its ANDA in April 2001. Hence, CTI, as well as the public, undisputedly had access to the PTO's interpretation of Bayer's original terminal disclaimer at the time CTI filed its ANDA. Thus, Bayer's prompt action precluded any prejudice to CTI or the public.

Finally, as Bayer points out, "no patentee could have anticipated the URAA patent extension" at the time Bayer filed its terminal disclaimer in 1992. The "October 01, 2002" date was simply the date of expiration of the Peterson '658 patent as calculated under then-existing law. Furthermore, Bayer disclaimed part of the '444 patent term pursuant to its ANDA related suit against [**16] Barr to defend against Barr's allegation that the '444 patent was invalid for double patenting over the two '658 patents. Thus, in context, Bayer intended to disclaim the term from the "earlier of the expiration dates of U.S.

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Patents Nos. 4,544,658 (issued October 1, 1985) and 4,556,658 (issued December 3, 1985)." Terminal Disclaimer.

As the district court correctly noted: "Bayer thereby voluntarily abandoned the protected term on the '444 patent to the extent that it exceeded the earlier patents, and agreed to enforce the '444 patent only up to the date on which the Peterson '658 patent would expire." Summary Judgment, at 2. Because the URAA amendments automatically changed the expiration date of the Peterson '658 patent from October 1, 2002 to December 9, 2003, the [*1383] expiration date of the '444 patent, which is contingent upon the expiration date

of the Peterson '658 patent, also changed simultaneously to December 9, 2003.

III.

In sum, the district court properly upheld the PTO's determination that the expiration date of the '444 patent as it relates to ciprofloxacin is December 9, 2003.

COSTS

Each party shall bear its own costs.

AFFIRMED.

TAB D



UNITED STATES, DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 45

SANOFI, INC.
PATENT DEPT.
9 GREAT VALLEY PARKWAY
P.O. BOX 3026
MALVERN, PA 19355

COPY MAILED

REMS 1/1996

OFFICE OF PETITIONS
4/CPATENES

In re Patent No. 4,818,816 :
Issue Date: April 4, 1989 :
Application No. 07/115,593 :
Filed: October 26, 1987 :
Patentees: Maurice Petitou et al. :
ON PETITION

This is a decision on the petition under 37 CFR 1.182, filed March 11, 1996, requesting that the terminal disclaimer under 35 U.S.C. § 253 filed on October 23, 1988 be withdrawn in favor of a newly submitted terminal disclaimer.

The petition is DENIED.

BACKGROUND

A Notice of Allowance and Notice of Allowability were mailed on June 13, 1988 in the above-identified application.

A terminal disclaimer under 35 U.S.C. § 253 and 37 CFR 1.321 was voluntarily filed on October 23, 1988. The terminal disclaimer of October 23, 1988 was executed by Pierre Williams on behalf on Choay, S.A., and stated that:

Your petitioner, Choay, S.A., hereby disclaims the terminal part of any patent on the above-identified application which would extend beyond the expiration date of U.S. Patent No. 4,607,025, issued on August 19, 1986, . . .

The above-identified application issued as U.S. Patent No. 4,818,816 on April 4, 1989.

The instant petition under 37 CFR 1.182 was filed on March 11, 1996, and requests that the terminal disclaimer filed on

October 23, 1988 be withdrawn in favor of a newly submitted terminal disclaimer stating that:

Choay, S.A., hereby disclaims, except as provided below, the terminal part of the statutory term of the above-identified patent which extends beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 of U.S. Patent No. 4,607,025, issued on August 19, 1986,

STATUTE AND REGULATION

35 U.S.C. § 253 states that:

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing and recorded in the Patent and Trademark Office, and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

35 U.S.C. § 255 provides that:

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

37 CFR 1.323 provides that:

Whenever a mistake of a clerical or typographical nature or of minor character which was not the fault of the Office, appears in a patent and a showing is made that such mistake occurred in good faith, the Commissioner may, upon payment of the fee set forth in § 1.20(a), issue a certificate, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. A request for a certificate of correction of a patent involved in an interference shall comply with the requirements of this section and shall be accompanied by a motion under § 1.635.

37 CFR 1.325 provides that:

Mistakes other than those provided for in §§ 1.322, 1.323, 1.324, and not affording legal grounds for reissue or for reexamination, will not be corrected after the date of the patent.

OPINION

Petitioner (Choay, S.A.) asserts that U.S. Patent No. 4,607,025 recently expired due to failure to pay a maintenance fee. Petitioner argues that the language of the terminal disclaimer filed on October 23, 1988 might be ambiguous as to whether the "expiration date of U.S. Patent No. 4,607,025" set forth therein is measured from the full statutory term of U.S. Patent No. 4,607,025, or the actual term U.S. Patent No. 4,607,025 due to the failure to timely submit a maintenance fee. Petitioner requests that the terminal disclaimer submitted with the instant petition be substituted for the terminal disclaimer filed on October 23, 1988 to resolve this potential ambiguity.

The statutory authority for amendment or correction of an issued patent is found in title 35, chapter 25. The instant petition does not involve correction of a mistake by the Patent and Trademark Office (Office) (35 U.S.C. § 254) or correction of the named inventor (35 U.S.C. § 256). In addition, while the instant petition involves a disclaimer, 35 U.S.C. § 253 merely authorizes the filing and recording of disclaimers; it does not authorize the withdrawal of a terminal disclaimer. Finally, petitioners have not sought amendment or correction by reissue (35 U.S.C. §§ 251 and 252).

Unless a "mistake" is provided for in 37 CFR 1.322, 1.323, or 1.324, or affords legal grounds for reissue or for reexamination,

such "mistake" will not be corrected subsequent to the issuance of an application as a patent. See 37 CFR 1.325. As stated in section 1490 of the Manual of Patent Examining Procedure (MPEP) (6th Ed., Rev. 1 1995), the mechanisms to correct a patent (i.e., certificate of correction (35 U.S.C. § 255), reissue (35 U.S.C. § 251), and reexamination (35 U.S.C. § 305)) are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer. The Supreme Court has stated that, as a general principle, public policy does not favor the restoration to a patent of that which has been dedicated to the public by disclaimer. See Altoona Publix Theatres, 294 U.S. 477, 492, 24 USPQ 308, 315 (1935); see also Leggett v. Avery, 101 U.S. (11 Otto) 256, 259-60 (1879).

In any event, to withdraw the terminal disclaimer filed on October 23, 1988 and properly recorded in the above-identified patent, such action must be authorized pursuant to 35 U.S.C. § 255.

A Certificate of Correction under 35 U.S.C. § 255 and 37 CFR 1.323 is available for the correction of errors of a minor or clerical character, and does not extend to the correction of errors that would constitute new matter or would require reexamination. See In re Arnott, 19 USPQ2d 1049, 1054 (Comm'r Pats. 1991); In re Hyman, 185 USPQ 441, 442 (Sol. Pat 1975). Specifically, 35 U.S.C. § 255 requires, *inter alia*, that two specific and separate requirements be met prior to the issuance of a Certificate of Correction. The first requirement is that the mistake is: (1) of a clerical nature, (2) of a typographical nature, or (3) of minor character. The second requirement is that the correction must not involve changes that would: (1) constitute new matter or (2) would require reexamination. See Arnott 19 USPQ2d at 1052; see also MPEP 1490.

The "mistake" at issue involves the failure to specify in the terminal disclaimer filed on October 23, 1988 that petitioner does not disclaim the terminal part of the above-identified patent which extends beyond the expiration date U.S. Patent No. 4,607,025, unless such expiration date is based upon the full statutory term defined in 35 U.S.C. §§ 154 to 156 of U.S. Patent No. 4,607,025. This "mistake," however, is not one of a clerical or typographical nature; rather, it involves a substantive re-drafting of the language in the terminal disclaimer to be recorded for the above-identified patent. In addition, as this "mistake" involves altering the language concerning the expiration date of the above-identified patent (i.e., correction of this "mistake" would potentially result in changing the term of the above-identified patent), this "mistake" cannot reasonably be characterized as one of minor character. See MPEP 1490.

Since the first requirement under 35 U.S.C. § 255 is not met (i.e., the "mistake" sought to be corrected is not of the type proper for correction under 35 U.S.C. § 255), whether the withdrawal of the terminal disclaimer filed on October 23, 1988 in favor of a newly submitted terminal disclaimer would constitute new matter or require reexamination is moot. Id.

Accordingly, the Certificate of Correction is not available for the requested correction.

Assuming, arguendo, that the patent statutes authorized the withdrawal of the terminal disclaimer filed on October 23, 1988 in favor of a newly submitted terminal disclaimer, such action would not constitute an appropriate exercise of the Commissioner's discretion under 37 CFR 1.182 or 1.183 or 35 U.S.C. § 255 and 37 CFR 1.323. Granting the requested relief would operate to evade the requirements of the reissue statutes (i.e., 35 U.S.C. §§ 251 and 252). The remedial nature of reissue notwithstanding, reissue is not available to correct all errors. Specifically, it is the Office's position that reissue is not available to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent. See Ex parte Anthony, 230 USPQ 467 (Bd. App. 1982), affd, Appeal No. 84-1357 (Fed. Cir. 1985); see also MPEP 1490.

Thus, the "mistake" at issue is not provided for in 37 CFR 1.322, 1.323, or 1.324, and does not afford legal grounds for reissue or for reexamination. Therefore, the PTO will not, pursuant to 37 CFR 1.182 or 1.183, withdraw or otherwise nullify the effect of a disclaimer properly recorded in an issued patent. See 37 CFR 1.325; MPEP 1490. The PTO, however, expresses no opinion on the effect on the above-identified patent of the expiration of U.S. Patent No. 4,607,025 for failure to timely pay a maintenance fee.

CONCLUSION

For the above stated reasons, the request to withdraw the terminal disclaimer under 35 U.S.C. § 253 and 37 CFR 1.321 filed on October 23, 1988 in favor of a newly submitted terminal disclaimer is denied.

Telephone inquiries should be directed to the Office of Petitions Staff at (703) 305-9282.

The patent file is being returned to Files Repository.



Jeffrey V. Nase
Patent Legal Administrator
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

rwb/ah

cc: SETH H. JACOBS
DAVIS, HOXIE, FAITHFULL & HAPGOOD
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TAB E



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 25

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SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS

THOMAS SARRO
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ALEXANDRIA, VIRGINIA 22314

In re Patent No: 4,346,116 :
Application No. 06/151,816 :
Filed: October 31, 1984 : DECISION DENYING PETITION
Issue date: August 24, 1982 :
Inventor: Francoise Verwaerde et al:

This is a decision on the renewed petition under 37 CFR 1.182, which now requests that the PTO "give notice to the public of the true expiration date of the patent, i.e., May 14, 1999."

The petition is DENIED.

BACKGROUND

In response to the final Office action of August 19, 1991, wherein the examiner rejected inter alia, various claims over claims 6 and 7 of copending application No. 038,711, applicants filed an amendment and a terminal disclaimer on December 21, 1981. The accompanying remarks noted:

"[t]he amendment (sic, rejection) of claims 27-34 and 37-40 as obvious variants of claims in Serial No. 038,711 is being obviated by the Terminal Disclaimer submitted herewith."

The application was allowed by the examiner in the Office communication mailed March 15, 1992, and issued August 24, 1982.

A petition filed September 11, 1997, requested under 37 CFR 1.182 that the recorded terminal disclaimer filed on December 21, 1981, be withdrawn in favor of a revised, apparently forthcoming, terminal disclaimer, and further, that a Certificate of Correction (PTO mistake) be issued to that effect. Petitioners specifically requested that the aforementioned original terminal disclaimer be replaced, in that the instant patent term, via the original terminal disclaimer, is limited to the pre "GATT-NAFTA" (Uruguay

Round Agreements Act (URAA) (1994)) expiration date for U.S. Patent No. 4,279,931 (July 21, 1998), while the latter patent now expires May 14, 1999, as was apparently to be reflected in any forthcoming terminal disclaimer. As such, petitioner asserted, the instant patent contains an erroneous date of expiration, and further, as the error in the patent is not the fault of petitioner, no fees for either the petition, or the requested Certificate of Correction, should be assessed.

The petition was dismissed in the decision of February 11, 1998.

The instant renewed petition was filed April 13, 1998.

STATUTE AND REGULATION

35 USC § 253 states that:

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

35 USC § 254 provides:

Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Commissioner may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Commissioner may issue a

corrected patent without charge in lieu of and with like effect as a certificate of correction.

35 USC § 255 states that:

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require re-examination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

37 CFR 1.182 provides that:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h).

37 CFR 1.322 provides that:

(a) A certificate of correction under 35 U.S.C. 254 may be issued at the request of the patentee or the patentee's assignee. Such certificate will not be issued at the request or suggestion of anyone not owning an interest in the patent, nor on motion of the Office, without first notifying the patentee (including any assignee of record) and affording the patentee an opportunity to be heard. When the request relates to a patent involved in an interference, the request shall comply with the requirements of this section and shall be accompanied by a motion under § 1.635.

(b) If the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form, the Commissioner may issue a corrected patent in

lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee.

37 CFR 1.321 states:

(a) A patentee owning the whole or any sectional interest in a patent may disclaim any complete claim or claims in a patent. In like manner any patentee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee and its successors or assigns. A notice of the disclaimer is published in the Official Gazette and attached to the printed copies of the specification. The disclaimer, to be recorded in the Patent and Trademark Office, must:

- (1) be signed by the patentee, or an attorney or agent of record;
- (2) identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term, will be refused recordation;
- (3) state the present extent of patentee's ownership interest in the patent; and
- (4) be accompanied by the fee set forth in § 1.20(d).

(b) An applicant or assignee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

- (1) be signed:
 - (i) by the applicant, or
 - (ii) if there is an assignee of record of an undivided part interest, by the applicant and such assignee, or
 - (iii) if there is an assignee of record of the entire interest, by such assignee, or
 - (iv) by an attorney or agent of record;

- (2) specify the portion of the term of the patent being disclaimed;
 - (3) state the present extent of applicant's or assignee's ownership interest in the patent to be granted; and
 - (4) be accompanied by the fee set forth in § 1.20(d).
- (c) A terminal disclaimer, when filed to obviate a judicially created double patenting rejection in a patent application or in a reexamination proceeding, must:
- (1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;
 - (2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and
 - (3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.
- (c) A terminal disclaimer, when filed to obviate a judicially created double patenting rejection in a patent application or in a reexamination proceeding, must:
- (1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;
 - (2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and
 - (3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.

37 CFR 1.323 states that:

Whenever a mistake of a clerical or typographical nature or of minor character which was not the fault of the Office, appears in a patent and a showing is made that such mistake occurred in good faith, the Commissioner may, upon payment of the fee set forth in § 1.20(a), issue a certificate, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. A for a certificate of correction of a patent involved in an interference shall comply with the requirements of this section and shall be accompanied by a motion under § 1.635.

OPINION

Petitioners request reconsideration in that the decision of February 11, 1998 is asserted to have failed to address the basis of the prior request filed September 11, 1997. Specifically petitioners assert, the Commissioner has authority under 37 CFR 1.182 to give notice to the public of the true expiration date of the above-captioned patent, which petitioner contends, is May 14, 1999.

The showing of record fails to adequately demonstrate that the facts of this case warrant the relief(s) requested.

The terminal disclaimer under 35 USC § 253 and 37 CFR 1.321, filed December 21, 1981, was relied upon by petitioners to overcome a rejection on the grounds of obviousness type double patenting involving the claims of commonly owned U. S. Patent No. 4,279,931 issued July 21, 1981. The terminal disclaimer was executed by Germain Roquette, on behalf of the assignee, Roquette Freres, and specified in pertinent part that:

"The said assignee does hereby disclaim and dedicate to the public the terminal portion of any United States Patent to be issued on this application beyond July 21, 1998."

While petitioners now predicate their request for withdrawal of the recorded terminal disclaimer upon a subsequent change in the term of the '931 patent, inspection of the above-quoted language in that disclaimer reveals that petitioners originally made such disclaimer contingent upon an actual date of expiration of the term of the '931 patent. That is, petitioners made the original terminal disclaimer absolute, that is, date-specific to July 21, 1998. It follows that regardless of what effect the URAA may have

subsequently had on the expiration date of the '931 patent, there is no nexus between that date and the specific expiration date as set forth in the original terminal disclaimer of record. As such, no error is apparent in the term of the original instant letters patent, as indicated by the recorded terminal disclaimer, which warrants correction. As such, it is not apparent from the record, and petitioner has not shown, on the record, how the express date certain patent expiration of July 21, 1998 given by the assignee of the entire interest, becomes May 14, 1999. Rather, as the patent was freely stated to expire on July 21, 1998 whatever effects the URAA might have had on the term of other patent, is simply immaterial to the date specific expiration of the above-captioned patent. Contrary to petitioners' contention, whatever authority may be vested under and by the patent statutes and rules of practice, such authority does not controvert the assignee's express statement of a date certain expiration of the instant patent. In other words, it is manifestly inconsistent with the express language supplied by petitioners in the above-noted terminal disclaimer to now aver that the "true expiration date" is any other than that specifically recited in the terminal disclaimer, and proclaimed to the public as part of the instant patent since its date of issuance.

It is also brought to petitioners' attention that:

"The purpose of the URAA [codified in part in 35 U.S.C. § 154] was not to extend patent terms, although it has that effect in some cases, but to harmonize the term provision of United States patent law with that of our leading trading partners which grant a patent term of 20 years from the date of filing of the patent application. Prior to June 8, 1995, U.S. patents had an expiration date under 35 U.S.C. Section 154 measured as 17 years from the date the patent issued, except where terminal disclaimers were filed. Amended section 154(a) now reads:

Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed.

35 U.S.C. § 154(a)(2) (1994).

For certain patents which were issued and for pending applications which were filed prior to June 8, 1995, a transitional provision preserves a guaranteed 17-year term, if it is longer than 20 years from filing, by the following provision:

The term of a patent that is in force on or that results from an application filed before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act shall be the greater of the 20-year term as provided in subsection (1), or 17 years from grant, subject to any terminal disclaimers.

Id. at Section 154(c)(1). Patents in the section 154(c)(1) category thus are entitled to keep or to enjoy the 17-year term from issuance of the patent or a 20-year from filing term, whichever is longer.¹ (emphasis added)

The statutory authority for amendment or correction of an issued patent is found in title 35, chapter 25. The instant petition does not involve correction of a mistake by the Patent and Trademark Office (Office) (35 USC § 254) or correction of the named inventor (35 USC § 256). In addition, while the instant petition involves a disclaimer, 35 USC § 253 merely authorizes the filing and recording of disclaimers; it does not authorize the withdrawal of a terminal disclaimer. Finally, petitioners have not sought amendment or correction by reissue (35 USC §§ 251 and 252).

Unless a "mistake" is provided for in 37 CFR 1.322, 1.323, or 1.324, or affords legal grounds for reissue or for reexamination, such "mistake" will not be corrected subsequent to the issuance of an application as a patent. See 37 CFR 1.325. As stated in section 1490 of the Manual of Patent Examining Procedure (MPEP) (6th Ed., Rev. 3 1997), the mechanisms to correct a patent (i.e., certificate of correction (35 USC § 255), reissue (35 USC § 251) and reexamination (35 USC § 305)) are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer.

¹ Merck & Co. v. Kessler, 80 F.3d 1543, 1547-1548, 38 USPQ2d 1347, 1349-1350 (Fed. Cir. 1996).

Further in this regard, the public has had fifteen (fifteen) years since the grant of the above-identified patent, to act on its facial representation that the term of this patent will expire, at the latest, on July 21, 1998. Similarly, petitioners have had, since the submission of the aforementioned terminal disclaimer on December 21, 1981, no reasonable basis to expect a term for this patent that would extend beyond July 21, 1998.

While petitioners may now consider the originally filed disclaimer to be unnecessary, or unnecessarily limiting, petitioners are, nevertheless, confronted with what has been characterized as "an unhappy circumstance", rather than a circumstance necessitating relief. See In re Jentoft, 392 F.2d 633, 639 n. 6, 157 USPQ 363, 368 n. 6 (CCPA 1968); MPEP 1490. When the question of whether or not a given set of claims in one application or patent is distinct from another set of claims in another application or patent with respect to obviousness double patenting arises, that question relates to the merits of an invention, and the appropriate remedy for resolution of that issue ultimately lies by appeal as provided by statute. See e.g. In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Petitioners had the opportunity to challenge the need for a terminal disclaimer, on appeal, but instead, freely chose to file a terminal disclaimer to avoid the rejection, during the prosecution of the application that led to the above-identified patent. Such does not afford proper legal or public policy grounds for requesting nullification of the terms of free dedication to the public contained in the previously filed terminal disclaimer by way of appeal, much less on petition. Cf. Ex Parte Anthony, 230 USPQ 467 (PBAI 1982) aff'd. No. 84-1357 (Fed. Cir. June 14, 1985).

Even assuming, *arguendo*, the relief(s) requested should be considered on petition, petitioners are reminded that, as a general rule, public policy does not favor the restoration to the patentee [applicant] of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner, e.g., intervening rights in the case of a reissue patent. See Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935). Petitioners have failed to provide a reasonable, much less any, assurance that the public interest will, or can be, protected if the relief(s) requested in this petition are given favorable consideration. In this regard, an applicant's use, and Office acceptance, of a terminal disclaimer is in the public interest because such encourages the disclosure of additional developments, the earlier filing of patent applications, and the earlier expiration of

patents whereby the inventions covered become freely available to the public. Jentoft, supra. It is brought to petitioners' attention that the principle against recapturing something that has been intentionally dedicated to the public dates back at least to Leggett v. Avery, 101 U.S. 246 (1879). As noted above, while petitioners may now consider the previously filed disclaimer to be unnecessary, or unnecessarily limiting, petitioners are, nevertheless, confronted with what has been characterized as "an unhappy circumstance", rather than a circumstance(s) necessitating relief. Jentoft at 639 n. 6, 157 USPQ at 368 n. 6.

Moreover, petitioners have made no attempt to explain their delay in presenting this petition, over two years after the implementation of the URAA. The public has thus had some two years within which to rely on the fact that, notwithstanding the URAA of 1994, and its effective date of June 8, 1995, petitioners permitted the original terminal disclaimer in this patent to continue in unabated force and effect. While petitioners should not infer that, had the instant petition been more seasonably presented, a different result might have been obtained; nevertheless, the record shows that petitioners did not diligently address the issues pertaining to the instant terminal disclaimer presented by the aforementioned URAA. Assuming, arguendo, that petitioners may, seasonably or otherwise, request rescission of the terminal disclaimer of record, equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable, due care and diligence. U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983).

In any event, to withdraw the recorded terminal disclaimer filed on December 21, 1981 and properly recorded in the above-identified patent, such action must be authorized pursuant to 35 USC § 255.

A Certificate of Correction under 35 USC § 255 and 37 CFR 1.323 is available for the correction of errors of a minor or clerical character, and does not extend to the correction of errors that would constitute new matter or would require reexamination. See In re Arnott, 19 USPQ2d 1049, 1054 (Comm'r Pat. 1991); In re Hyman, 185 USPQ 441, 442 (Sol. Pat. 1975). Specifically, 35 USC § 255 requires, *inter alia*, that two specific and separate requirements be met prior to the issuance of a Certificate of Correction. The first requirement is that the mistake is: (1) of a clerical nature, (2) of a typographical nature, or (3) of minor character. The second requirement is that the correction must not involve changes that would: (1) constitute new matter or (2) would

require reexamination. See Arnott 19 USPQ2d at 1052; see also MPEP 1490.

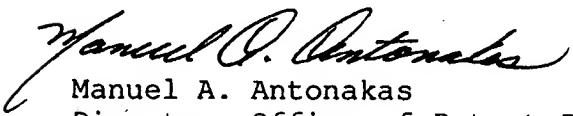
Apparently, the "mistake" at issue here involves petitioners' inclusion in the terminal disclaimer filed December 21, 1981, of a specific expiration date: July 21, 1998. However, this "mistake" is not one of a clerical or typographical nature; rather correcting this "mistake" would involve a substantive change to the recorded terminal disclaimer of record. Secondly, the "broadening" of the claims of a patent, via the attempted removal of a recorded terminal disclaimer, requires reexamination (pursuant to 35 USC § 251) of the issues raised thereby. See Anthony, supra. Further, in this regard, even while 35 USC 251 is a remedial statute, and, as such, is often liberally construed, nevertheless, there is a two year bar on any remedy that would effectuate broadening of an issued patent. See 35 USC 251. As held in Anthony, however, removal of a recorded terminal disclaimer, and the resultant "broadening" of the vertical scope (term) of the original patent, is prohibited, *inter alia*, if the attempt via reissue is not sought within two years of the patent grant. See id. at 470. It would appear to be an improper exercise of 37 CFR 1.182 to permit petitioner to regain, on petition, what petitioner could not herein regain under the remedial patent statute, which, as such, is "liberally construed." Under the facts of this case, it would be an inappropriate exercise of 37 CFR 1.182 to rescind the terminal disclaimer.

DECISION

For the reasons given above, it would be an inappropriate exercise of 37 CFR 1.182 to rescind the terminal disclaimer of record. Accordingly, the petition is granted to the extent that the previous decision has been reconsidered, but is **denied** as to rescinding the terminal disclaimer of record.

This patent file is being returned to the Files Repository.

Telephone inquiries relative to this decision should be directed to Special Projects Examiner Brian Hearn at (703) 305-1820.



Manuel A. Antonakas
Director, Office of Patent Policy Dissemination
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

TAB F



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 50

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SPECIAL PROGRAMS OFFICE
DAB FOR PATENTS

In re Application of:
David L. Marshall :
Application No. 07/096,207 :
Filed: December 18, 1990 :
Attorney Docket No. 85-US-0050M :

This is a decision on the renewed petition filed February 2, 1998, which requests under 37 CFR 1.182 that the terminal disclaimer filed on July 20, 1993 as part of a petition under 37 CFR 1.183 and 1.137(b), which Terminal Disclaimer was accepted for the term of forty three (43) months, be withdrawn in favor of the terminal disclaimer proffered with the initial petition, which latter term is of two (2) days.

The petition is DENIED.

BACKGROUND

Application No. 07/096,207 ('207) filed September 8, 1987 was a properly filed continuing application of application No. 06/807,157 filed December 10, 1985. In due course, the '207 application received a non-final Office action mailed December 18, 1987 which set a shortened statutory period of three (3) months within which to respond. A three month extension of time under 37 CFR 1.136(a), to extend the period for response to June 18, 1988 having been obtained by the communication filed June 22, 1988 (timely by way of the certificate of mailing bearing the date of June 18, 1998), the '207 application became abandoned at midnight, June 18, 1988 by operation of 35 USC 133.

On June 18, 1988, applicant deposited papers with the U.S. Postal Service via first class mail which requested a continuation under 37 CFR 1.62 of the '207 application. As the papers were received at the PTO on June 22, 1988, that date became the filing date for application No. 07/220,882 ('882), notwithstanding the lack of copendency with the '207 case. Petitioner was informed of the

filings dates and application numbers for all the aforementioned applications by way of the filing receipt received by counsel for petitioner on or about September 22, 1988 (Exhibit A).

In due course, the '882 application gave way to application No. 07/630,365 ('365) filed under 37 CFR 1.62 on December 18, 1990, which ultimately issued as U.S. Patent No. 5,236,826 ('826) patent issued on August 17, 1993.¹ Petitioner was likewise informed of the filing dates and application numbers for all the aforementioned applications by way of a filing receipt for the '365 application. During the pendency of the '365 application, applicant noted the lack of copendency between the parent '207 and '883 applications, and filed the petition under 37 CFR 1.183 and 1.137(b) to revive the '207 application to obtain copendency with the '883 application on July 20, 1992. The accompanying terminal disclaimer disclaimed four years and one month i.e., forty nine (49) months. The petition was granted in the decision of February 17, 1993, which accepted a disclaimer of forty three (43) months of the terminal part of any patent to be granted on the application which was being revived. Moreover, the decision also required that any application claiming benefit under 35 USC 120 of the revived application had to also request that the disclaimer be recorded against the latter application. Consequently, the '826 patent, as issued, facially disclaimed its term subsequent to January 17, 2007.

A first petition under 37 CFR 1.183 was filed June 14, 1996, and was treated as petition under 37 CFR 1.182, which petition was dismissed in the decision of October 30, 1997.

The instant petition was filed February 2, 1998.

STATUTE AND REGULATION

35 USC § 253 states that:

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent.

¹Under the practice of 37 CFR 1.62, all of the above-noted files have been "bundled" into one wrapper.

disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

35 USC § 254 provides:

Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Commissioner may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Commissioner may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

35 USC § 255 states that:

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require re-examination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

37 CFR 1.182 provides that:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the

Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h).

37 CFR 1.322 provides that:

(a) A certificate of correction under 35 U.S.C. 254 may be issued at the request of the patentee or the patentee's assignee. Such certificate will not be issued at the request or suggestion of anyone not owning an interest in the patent, nor on motion of the Office, without first notifying the patentee (including any assignee of record) and affording the patentee an opportunity to be heard. When the request relates to a patent involved in an interference, the request shall comply with the requirements of this section and shall be accompanied by a motion under § 1.635.

(b) If the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form, the Commissioner may issue a corrected patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee.

37 CFR 1.321 states:

(a) A patentee owning the whole or any sectional interest in a patent may disclaim any complete claim or claims in a patent. In like manner any patentee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee and its successors or assigns. A notice of the disclaimer is published in the Official Gazette and attached to the printed copies of the specification. The disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) be signed by the patentee, or an attorney or agent of record;

(2) identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term, will be refused recordation;

(3) state the present extent of patentee's ownership interest in the patent; and

(4) be accompanied by the fee set forth in § 1.20(d).

(b) An applicant or assignee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) be signed:

(i) by the applicant, or

(ii) if there is an assignee of record of an undivided part interest, by the applicant and such assignee, or

(iii) if there is an assignee of record of the entire interest, by such assignee, or

(iv) by an attorney or agent of record;

(2) specify the portion of the term of the patent being disclaimed;

(3) state the present extent of applicant's or assignee's ownership interest in the patent to be granted; and

(4) be accompanied by the fee set forth in § 1.20(d).

(c) A terminal disclaimer, when filed to obviate a judicially created double patenting rejection in a patent application or in a reexamination proceeding, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision that any patent granted on that application or any patent subject to the reexamination

proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.

(c) A terminal disclaimer, when filed to obviate a judicially created double patenting rejection in a patent application or in a reexamination proceeding, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.

37 CFR 1.323 states that:

Whenever a mistake of a clerical or typographical nature or of minor character which was not the fault of the Office, appears in a patent and a showing is made that such mistake occurred in good faith, the Commissioner may, upon payment of the fee set forth in § 1.20(a), issue a certificate, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. A certificate of correction of a patent involved in an interference shall comply with the requirements of this section and shall be accompanied by a motion under § 1.635.

OPINION

Petitioner reasserts that the forty three month period currently disclaimed in the above-identified application constitutes an unjust penalty herein in light of the two days of actual hiatus in pendency in the '207 and '882 parent applications. As such, petitioner asserts, the facts of this case constitute an extraordinary situation, such that the terminal disclaimer proffered with the petition, which is limited to the two day

period of hiatus in copendency, should be accepted by the PTO in lieu of the terminal disclaimer currently of record, and a certificate of correction issued to that effect.

In actuality, since the '207 application is abandoned and, as such, has no enforceable rights, petitioner belatedly seeks to extend the term of enforcement of the '826 patent by forty three (43) months, less two days.

The showing of record fails to adequately demonstrate that the facts of this case warrant the relief(s) requested.

Petitioner appears to confuse the forty three (43) month time period application No. 07/096,207 remained abandoned before it was revived, with the two day period of time in which there was a hiatus in copendency between the '207 application, and its continuing application No. 07/220,882 filed June 22, 1998.

Petitioner's two day hiatus in copendency, nevertheless, was not remedied until the filing of a grantable petition in excess of some forty three months after that hiatus occurred.² That is, petitioner required in excess of forty three months to discover, and remedy, an error of petitioner's own making. As a prerequisite to a grantable petition, petitioner submitted a disclaimer of the time equivalent to the period of abandonment in that abandoned application, as well as in any future continuing application (which includes the instant application) which claims benefit under § 120 of the aforementioned application. Petitioner is reminded that the statutes and regulations did not compel petitioner to rely upon those early application(s) for benefit under 35 USC 120, in the instant application. However, since petitioner desires to be entitled to the potential benefits of those earlier application(s) via § 120 and specifically, the above-identified application, then petitioner must also accept the consequences attendant to that action. See Abbott Laboratories v. Novopharm Ltd., 38 USPQ2d 1309, 1312 (D.C. N. Il. 1996), aff'd 104 F.3d. 1305, 41 USPQ2d 1535 (Fed. Cir. 1997). That is, petitioner is not in a good position to urge that the forty three month loss

² It is worth noting that petitioner voluntarily initially tendered a disclaimer of four years and one month, i.e., forty nine (49) months, while the decision on petition accepted a disclaimer of but forty three (43) months. That is, while petitioner was initially willing to forego even more time (over four years) than was actually assessed, petitioner now feels that two days is reasonable under the circumstances.

of term caused by petitioner's improper filing of the successor to this application be forgiven, at the same time that petitioner simultaneously claims the benefit of the filing date of both applications under 35 USC 120. See Id.

There is no dispute that application No. 07/096,207 was abandoned for in excess of forty three months prior to its revival and the resultant establishment of copendency with application No. 07/220,882 on petition, and, as such, there is no error with respect to the period disclaimed in the recorded terminal disclaimer. Even assuming, *arguendo*, the relief(s) requested should be considered on petition, petitioner is reminded that, as a general rule, public policy does not favor the restoration to the patentee [applicant] of something that has been freely dedicated [here, forty three months of the patent term] to the public, particularly where the public interest is not protected in some manner, e.g., intervening rights in the case of a reissue patent. See Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935). Petitioner has failed to provide a reasonable, much less any, assurance that the public interest will, or can be, protected if the relief(s) requested in this petition is given favorable consideration. In this regard, an applicant's use, and Office acceptance, of a terminal disclaimer is in the public interest because such encourages the disclosure of additional developments, the earlier filing of patent applications, and the earlier expiration of patents whereby the inventions covered become freely available to the public. See In re Jentoft, 392 F.2d 633, 157 USPQ 363 (CCPA 1968).

It is brought to petitioner's attention that the principle against recapturing something that has been intentionally dedicated to the public dates back at least to Leggett v. Avery, 101 U.S. 246 (1879). In this regard, the public had almost three years since the grant of the above-identified patent to act on its facial representation that the term of the above-captioned patent will expire January 17, 2007, before the first petition was filed herein. Similarly, petitioner has had, since the submission of the aforementioned terminal disclaimer, which was proffered to secure revival for the sole purpose of obtaining copendency, no reasonable basis to expect a patent term that would extend beyond January 17, 2007. While petitioner may now consider the previously filed disclaimer to be unnecessary, or unnecessarily limiting, petitioner is, nevertheless, confronted with what has been characterized as "an unhappy circumstance", rather than a circumstance necessitating relief. See In re Jentoft, 392 F.2d 633, 639 n. 6, 157 USPQ 363, 368 n. 6 (CCPA 1968); MPEP 1490.

Petitioner had the opportunity, when the petition of July 20, 1992 was under consideration by the PTO, to request relief from the requirement for a terminal disclaimer, and/or the extent of the term disclaimed, but did not do so. Moreover, petitioner has provided no adequate explanation as to why the circumstances surrounding this patent warrant a belated consideration of this issue, some three years after the petition was granted, and the terminal disclaimer was accepted, on February 17, 1993. Equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable, due care and diligence. U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983).

The Patent and Trademark Office did not cause or contribute to petitioner's failure to properly obtain copendency, in that petitioner relied upon the certificate of mailing procedure. It is well established, and well publicized, that the certificate of mailing practice under 37 CFR 1.8 is ineffective to obtain a filing date earlier than the date of receipt of the application papers at the PTO. See Vincent v. Mossinghoff, 230 USPQ 621, 625 (D.D.C. 1985). While the PTO did contribute to petitioner's delay in realizing the true abandoned status of application No. 07/096,207 such that the aforementioned petition to revive was untimely within the meaning of (then) 37 CFR 1.137(b), such PTO contribution nevertheless, was duly considered, and resulted in the favorable decision on petition, which decision revived the '207 application such that copendency was obtained, and also required the terminal disclaimer at issue.

Petitioner's reliance on In re Wilson, 8 USPQ2d 1375 (Comm'r Pat. 1988) (requirement for a terminal disclaimer under 37 CFR 1.137(c) that would have required a loss of eleven (11) years of patent term waived due to extraordinary circumstances) in support of petitioner's request for an abbreviated terminal disclaimer is noted. However, Wilson gives no guidance as to what extraordinary circumstances therein led to waiver of the terminal disclaimer, nor does either petitioner proffer, or inspection of the instant record reveal, that any extraordinary circumstances, much less the same circumstances as in Wilson, are present and operative herein. Rather, Wilson's counsel's reasonable misinterpretation of 37 CFR 1.8 (in 1977) led to revival (not waiver) under the unavoidable standard, in Wilson. However, as noted in Vincent, supra, by 1979 the inapplicability of 37 CFR 1.8 to obtaining copendency when relying upon the date of deposit was well publicized. Still further, contrary to petitioner's assertions, the PTO was under no obligation to notify petitioner of his mistake in relying upon the

certified mailing procedure, much less research whether copendency had been obtained. Vincent, Id. While the PTO does attempt to notify parties of defective papers, it is applicant who is ultimately responsible for filing proper documents. See Id.; In re Colombo Inc., 33 USPQ2d 1530, 1531 (Comm'r Pat. 1994). Rather, as in Vincent, petitioner was provided with a filing receipt (see petition of July 20, 1992, exhibit A) that inter alia, correctly listed the actual filing dates for all involved applications, and furthermore, that filing receipt admonished applicant to verify the accuracy of the data thereon.

Furthermore, petitioner concededly received the filing receipt, and, as such, petitioner was put on reasonable notice of the lack of copendency well before the one year time limit of former 37 CFR 1.137 had expired. Note in this regard, that petitioner had specifically requested to extend the response period in the '207 application to June 18, 1987, and was shortly thereafter informed that the filing date of the continuing application was June 22, 1988, not June 18, 1988. Nevertheless, petitioner failed to provide the necessary (and timely) reply to the filing receipt: a petition under 37 CFR 1.137(b) to revive this application to obtain copendency. The failure to supply the proper reply was the fault of petitioner, not the PTO. As noted in Brenner v. Ebbert, 398 F.2d. 762, 765, 157 USPQ 609, 611 (D.C. Cir. 1968), cert. den. 159 USPQ 799:

The Constitution requires notice reasonably designed to forewarn against approaching default; but it does not insure against the effects of a mistaken response to timely notice knowingly received.

It follows that petitioner had received the reasonable notice required so as ensure a timely and full response to the filing receipt. That petitioner failed to timely and adequately respond was unfortunate, but such failure was avoidable by the exercise of ordinary care and diligence. See Brenner, supra. As such, had petitioner diligently filed a petition seeking to revive this application for copendency purposes under 37 CFR 1.137(b), the very terminal disclaimer that petitioner now seeks to vitiate would have been unnecessary. That is, under the terms of former 37 CFR 1.137(b), a terminal disclaimer was not required if a grantable petition to revive was filed within one year of the date of abandonment. Rather, a terminal disclaimer was only required pursuant to 37 CFR 1.183, when the one year filing period of 37 CFR 1.137(b)(4) was waived. As in Vincent, applicant's, and applicant's counsel's failure to exercise reasonable, due care and

diligence does not constitute grounds for requesting an extraordinary remedy. Lockheed, supra.

That is, that counsel (1) erroneously applied 37 CFR 1.8 in lieu of 1.10, to file an application where copendency was sought, and (2) failed to duly observe the lack of copendency expressly noted upon the subsequently issued filing receipt, does not represent circumstances that were beyond the control of petitioner, or counsel for petitioner. Rather, such circumstances could have been avoided merely by the exercise of reasonable, due care and diligence. Circumstances resulting from petitioner's, or petitioner's counsel's, failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc. 195 USPQ 586, 588 (Comm'r Pats. 1977). Moreover, even assuming that clerical inadvertence or mistake in former counsel's office caused or contributed to the asserted filing error, such is not adequate grounds for requesting extraordinary relief. See In re Kabushiki Kaisha Hitachi Seisakusho, 39 USPQ2d 1319, 1320 (Comm'r Pat. 1994) (clerical error causing delay resulting in a statutory bar does not warrant suspension of the rules).

Further in this regard, in light of the filing receipt which clearly pointed out the lack of copendency, that petitioner required some forty three months to realize that copendency had not been obtained, does not warrant PTO acceptance of a terminal disclaimer of two days. That is, as counsel for petitioner had received the filing receipt, petitioner had constructive notice of the lack of copendency. That is, notice given to applicant's representative of record constitutes notice to applicant.

Rosenberg v. Carr Fastener Co., 10 USPQ 106, 51 F.2d 1014 (2nd Cir. 1931), cert. denied, 284 U.S. 652. While counsel may have failed to properly obtain pendency, and then may have failed to note the lack of pendency, the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and petitioner is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987). Moreover, petitioner did not discover the lack of copendency in two days; petitioner required a time period in excess of forty three months. Thus, there is no

adequate showing of an extraordinary situation warranting the requested relief. See, Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require exceptional remedies, when a party makes an avoidable mistake in filing papers). Had petitioner duly observed the lack of copendency within two days of the actual fact, and immediately presented a petition to remedy the situation, petitioner would be in a better position to request PTO acceptance of a terminal disclaimer limited to but two days.

The Office, where it has the power to do so, should not relax the requirements of established practice in order to save an applicant from the consequence of his delay. See Ex parte Sassin, 1906 Dec. Comm'r Pat. 205, 206 (Comm'r Pat. 1906) and compare Ziegler v. Baxter v. Natta, 159 USPQ 378 379 (Comm'r Pat. 1968) and Williams v. The Five Platters, Inc., 510 F.2d 963, 184 USPQ 744 (CCPA 1975). In this regard, the established PTO practice was (1) to require, for a grantable petition under 37 CFR 1.183 and 1.137(b), a terminal disclaimer equivalent to the time period in months that the application remained abandoned, and (2) to require that the terminal disclaimer be recorded against any application claiming § 120 benefits of the application being revived.

Moreover, the PTO did not cause or contribute to petitioner's three year delay in presenting the initial petition, during which time the public has been continuously apprised that the term of the patent expires on January 17, 2007, by operation of the recorded Terminal disclaimer. Petitioner is reminded that the terminal disclaimer was then required as a condition for waiver of the one year time period of 37 CFR 1.137(b), under the authority of 37 CFR 1.183 (i.e., "subject to such other requirements as may be imposed.")³ Such does not afford proper legal or public policy grounds for requesting nullification of the terms of free

³ It is noted that, effective December 1, 1997, 37 CFR 1.137(b) was amended to delete the one year time period for filing a petition to revive thereunder, while 37 CFR 1.137(c) was also amended to require, for applications filed before June 8, 1995, the filing of a terminal disclaimer as part of a petition submitted under 37 CFR 1.137(b). The time period required to be disclaimed is equivalent to the interval starting from when the application became abandoned, and ending when a grantable petition was filed. See the final notice entitled "Changes to Patent Practice and Procedure", 62 Fed. Reg. 53132, 53160 (October 10, 1997).

dedication to the public contained in the previously filed terminal disclaimer by way of appeal, much less on petition. Cf. Ex Parte Anthony, 230 USPQ 467 (PBAI 1982) aff'd. No. 84-1357 (Fed. Cir. June 14, 1985).

The statutory authority for amendment or correction of an issued patent is found in title 35, chapter 25. The instant petition does not involve correction of a mistake by the Patent and Trademark Office (Office) (35 USC § 254) or correction of the named inventor (35 USC § 256). In addition, while the instant petition involves a disclaimer, 35 USC § 253 merely authorizes the filing and recording of disclaimers; it does not authorize the withdrawal of a terminal disclaimer. Finally, petitioner has not sought amendment or correction by reissue (35 USC §§ 251 and 252).

Unless a "mistake" is provided for in 37 CFR 1.322, 1.323, or 1.324, or affords legal grounds for reissue or for reexamination, such "mistake" will not be corrected subsequent to the issuance of an application as a patent. See 37 CFR 1.325. As stated in section 1490 of the Manual of Patent Examining Procedure (MPEP) (6th Ed., Rev. 3 1997), the mechanisms to correct a patent (i.e., certificate of correction (35 USC § 255), reissue (35 USC § 251) and reexamination (35 USC § 305)) are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer.

In any event, to withdraw the terminal disclaimer filed January 28, 1993 and properly recorded in the above-identified patent, such action must be authorized pursuant to 35 USC § 255.

A Certificate of Correction under 35 USC § 255 and 37 CFR 1.323 is available for the correction of errors of a minor or clerical character, and does not extend to the correction of errors that would constitute new matter or would require reexamination. See In re Arnott, 19 USPQ2d 1049, 1054 (Comm'r Pat. 1991); In re Hyman, 185 USPQ 441, 442 (Sol. Pat. 1975). Specifically, 35 USC § 255 requires, inter alia, that two specific and separate requirements be met prior to the issuance of a Certificate of Correction. The first requirement is that the mistake is: (1) of a clerical nature, (2) of a typographical nature, or (3) of minor character. The second requirement is that the correction must not involve changes that would: (1) constitute new matter or (2) would require reexamination. See Arnott 19 USPQ2d at 1052; see also MPEP 1490.

Apparently, the "mistake" at issue here involves petitioner's lack of inclusion in the terminal disclaimer filed January 28,

1993, of a term of two days. However, this "mistake" is not one of a clerical or typographical nature; rather correcting this "mistake" would involve a substantive change to the recorded terminal disclaimer of record. Secondly, the "broadening" of the claims of a patent, via the attempted removal of a recorded terminal disclaimer, requires reexamination (pursuant to 35 USC § 251) of the issues raised thereby. See Anthony, supra.

Rather, the "broadening" of the claims of a patent, via the attempted removal of a recorded terminal disclaimer, requires reexamination (pursuant to 35 USC § 251) of the issues raised thereby. See Anthony, supra. Further, in this regard, even while 35 USC § 251 is a remedial statute, and, as such, is often liberally construed, nevertheless, there is a two year bar on applying for any remedy that would effectuate broadening of an issued patent. See 35 USC 251, ¶ 4. As held in Anthony, however, removal of a recorded terminal disclaimer, and the resultant "broadening" of the vertical scope (term) of the original patent, is prohibited, *inter alia*, if the attempt via reissue is not sought within two years of the patent grant. See Id. at 470. That is, the requested nullification here, as in Anthony, of the recorded terminal disclaimer would increase the period of enforceability of the originally granted patent. It would be an improper exercise of 37 CFR 1.182 to permit petitioner to regain, on petition, what petitioner could not regain under the remedial patent statute, which, as such, is "liberally construed."

DECISION

For the reasons given above, it would be an inappropriate exercise of 37 CFR 1.182 to rescind the terminal disclaimer of record. Accordingly, the petition is granted to the extent that the previous decision has been reconsidered, but is **denied** as to rescinding the terminal disclaimer of record.

This patent file is being returned to the Files Repository.

Telephone inquiries relative to this decision should be directed to Special Projects Examiner Brian Hearn at (703) 305-1820.



Manuel A. Antonakas
Director, Office of Patent Policy Dissemination
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects



MACH2/CON

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patentees : Bernard F. Mach et al.
Patent No. : 6,818,393 B1
Issued : November 16, 2004
On Application No. : 08/484,786 Confirmation No. : 4894
Filed : June 7, 1995
For : DNA SEQUENCES CODING FOR THE DR BETA-
CHAIN LOCUS OF THE HUMAN LYMPHOCYTE
ANTIGEN COMPLEX AND POLYPEPTIDES,
DIAGNOSTIC TYPING PROCESSES AND
PRODUCTS RELATED THERETO
Group Art Unit : 1634
Examiner : Jehanne Souaya Sitton

New York, New York
January 24, 2005

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REQUEST UNDER 37 C.F.R. § 1.323
FOR CERTIFICATE OF CORRECTION

Sir:

This is to request a Certificate of Correction under 37 C.F.R. § 1.323 in the above-identified patent. Under 35 U.S.C. § 255, such a Certificate is available for the correction of errors of a typographical or clerical character, provided that the correction does not involve

changes that would constitute new matter or require reexamination. Patentees have enclosed Form PTO-1050 (in duplicate) listing two errors that have been found in the above-identified patent. These errors are believed to be the responsibility of the patentees.

First, the Assignee information printed on the front page of the issued patent should read “bioMérieux S.A.” instead of “bioMirieux sa”. Patentees believe that this error is of a typographical or clerical nature and does not constitute new matter or require reexamination.

Second, patentees request correction of an inadvertent typographical or clerical error in the Terminal Disclaimer submitted on April 6, 2004 (copy attached at Tab A). This Terminal Disclaimer was filed to obviate a non-statutory double patenting rejection over parent Application No. 07/902,999, filed June 23, 1992, now U.S. Patent 5,503,976 (“the ‘976 patent”), issued April 2, 1996. As a patent issued after June 8, 1995 on an application pending on June 8, 1995, the ‘976 patent is entitled to a term which expires on the later of 17 years from its issue date or 20 years from its filing date. In this case, April 2, 2013 (17 years from the issue date) is the expiration date of the parent ‘976 patent.

Patentees request this correction to the Terminal Disclaimer filed in U.S. Patent 6,818,393 (“the ‘393 patent”) because it contains an ambiguity with regard to the date beyond which the term of the ‘393 patent is disclaimed. The Terminal Disclaimer clearly describes this date as the expiration date of the full statutory term of the parent ‘976 patent. In particular, the second paragraph on page 2 states:

“The undersigned, on behalf of BIOMERIEUX, hereby disclaims the terminal portion of any patent granted on the above-identified ‘786 application, which would extend beyond **the expiration date of the full statutory term of the ‘976 patent**” (emphasis added).

In the first full paragraph on page 3, the Terminal Disclaimer further specifies that

“[t]he undersigned, on behalf of BIOMERIEUX, does not disclaim any terminal portion of any patent granted on the above-identified ‘786 application prior to December 8, 2009, **the expiration of the full statutory term of the ‘976 patent**” (emphasis added).

At the same time, the Terminal Disclaimer erroneously identifies the calendar date of the expiration of the full statutory term of the ‘976 patent as December 8, 2009 instead of April 2, 2013 (see page 3, line 9). The Terminal Disclaimer, therefore, misidentifies the calendar date beyond which the term of the ‘393 patent is disclaimed. To correct the resulting ambiguity, patentees request correction of page 3, line 9 of the Terminal Disclaimer to replace “December 8, 2009” with “April 2, 2013”.

As the Declaration of Margaret A. Pierri, attached at Tab B, demonstrates, the ambiguity described above is due to a typographical or clerical error that occurred during the preparation of the Terminal Disclaimer. Specifically, the attorney who drafted the Terminal Disclaimer used as a template a terminal disclaimer that she had previously drafted for a related application in the same patent family. In the template terminal disclaimer, the date beyond which the patent term was being disclaimed was the expiration date of related U.S. Patent No. 5,169,941, December 8, 2009. The attorney copied the template terminal disclaimer and revised

the number of the patent involved. However, she inadvertently neglected to revise the relevant expiration date. Consequently, the Terminal Disclaimer as filed mistakenly states that the calendar date of the expiration of the ‘976 patent is December 8, 2009.

Federal Circuit case law supports the correction of an ambiguous terminal disclaimer. In particular, the Federal Circuit has held that correction of PTO records is appropriate where a terminal disclaimer refers to two different expiration dates. See Bayer AG v. Carlsbad Tech., Inc., 298 F.3d 1377, 64 U.S.P.Q.2d 1045 (Fed. Cir. 2002) (“Bayer”, attached at Tab C). In Bayer, a terminal disclaimer indicated interdependence between related patents in addition to reciting a specific expiration date. As a result, the Federal Circuit held that the disclaimed term was “due to” the patent referred to, rather than independent of it. Id. at 1382. The Federal Circuit also held that the public had not been prejudiced by the correction, noting that the patentee had acted promptly to rectify the ambiguity. Id.

Here, as in Bayer, the Terminal Disclaimer is ambiguous because it refers to two different expiration dates, “the expiration date of the full statutory term of the ‘976 patent” (i.e., April 2, 2013), and a specific calendar date, “December 8, 2009”. Like the terminal disclaimer in Bayer, patentee’s Terminal Disclaimer clearly indicates interdependence between the ‘393 and ‘976 patents, disclaiming the portion of the term “which would extend beyond the expiration date of the full statutory term of the ‘976 patent” (see page 2, second paragraph) and stating that any portion of the term prior to “the expiration of the full statutory term of the ‘976 patent” is not disclaimed (see page 3, first full paragraph). Thus, correction of the Terminal Disclaimer to

replace an erroneous calendar expiration date, December 8, 2009, with the correct expiration date of the ‘976 patent, April 2, 2013, is in keeping with Bayer. In addition, as in Bayer, the correction of the Terminal Disclaimer will not prejudice the public. The Terminal Disclaimer clearly refers to “the expiration date of the full statutory term of the ‘976 patent”. Furthermore, patentees are filing this Request before the public receives notice of the Terminal Disclaimer in the Official Gazette. For these reasons, the Bayer decision supports correction of the Terminal Disclaimer.

Various decisions of the Commissioner for Patents regarding requests to correct terminal disclaimers have been made available to the public on the USPTO website. Although some of these decisions have denied requests to correct terminal disclaimers, the facts of each of these cases differ significantly from those here. See In re Patent No. 4,818,816, Paper No. 45 (“Petitou”; attached at Tab D); In re Patent No. 4,346,116, Paper No. 25 (“Verwaerde”; attached at Tab E); In re Application of David L. Marshall, Application No. 07/096,207, Paper No. 50 (“Marshall”; attached at Tab F).

In the Petitou decision, a request to withdraw a terminal disclaimer in favor of a newly submitted terminal disclaimer was denied because it involved “a substantive redrafting of the language in the terminal disclaimer” rather than correction of a typographical or clerical error within the scope of 37 C.F.R. § 1.323 (see Petitou decision at, e.g., page 4). Here, in contrast, patentees seek only to correct a clear error in the stated expiration date of the ‘976 patent, the correction of which does not involve substantive redrafting of patentee’s Terminal Disclaimer.

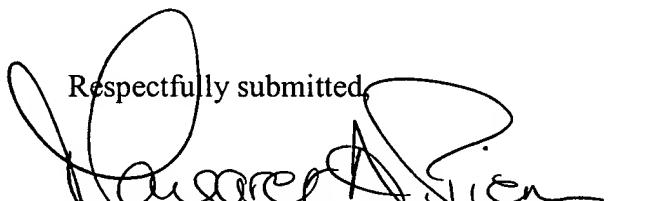
Such a correction of a typographical or clerical error (see discussion above, pages 3-4) is outside the scope of the Petitou decision.

In the Verwaerde decision, a request to withdraw a terminal disclaimer in favor of a revised terminal disclaimer was denied because “petitioners made the original terminal disclaimer absolute, that is, date-specific to July 21, 1998” (see Verwaerde decision at, e.g., page 6). The Terminal Disclaimer at issue here is distinguishable because it is not “absolute” in terms of specifying only one date. Rather, as discussed above, the Terminal Disclaimer refers repeatedly to the “full statutory term of the ‘976 patent”. Because it is plain from the face of the Terminal Disclaimer that the ‘393 and ‘976 patents are interdependent and that patentees’ reference to the date “December 8, 2009” was an error, the Verwaerde decision does not apply.

In the Marshall decision, a request to substitute a terminal disclaimer with a revised terminal disclaimer was denied where the petitioner failed to file the request with reasonable due care and diligence. Because the petitioner filed the request over three years after the terminal disclaimer had been accepted and over two years and nine months after the patent had issued, grant of the request threatened the public interest (see Marshall decision at, e.g., pages 8-9). Here, in contrast, patentees are acting promptly to correct the Terminal Disclaimer. Because patentees have filed this Request prior to publication of notice of the Terminal Disclaimer in the Official Gazette, there is no risk of detriment to the public based on reliance on the disclaimer. Thus, the Marshall decision is clearly distinguishable from the present situation.

In view of the above discussion, it is respectfully submitted that the correction to patentee's Terminal Disclaimer described above is of typographical or clerical nature, does not constitute new matter and requires no reexamination. Patentees request entry of the correction.

A check in the amount of \$100.00, in payment of the fee set forth in 37 C.F.R. § 1.20(a) is enclosed herewith. The Director is authorized to charge any additional fee required in connection with this Request to Deposit Account No. 06-1075. A duplicate copy of this Request is enclosed.

Respectfully submitted,


Margaret A. Pierri (Reg. No. 30,709)
Attorney for Patentees

c/o FISH & NEAVE IP GROUP
ROPES & GRAY LLP
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020-1105
Tel.: (212) 596-9000
Fax: (212) 596-9090

TAB A



Response Under 37 CFR 1.116
Expedited Procedure
Examining Group 1634

Docket No. MACH2/CON

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Examiner : Jehanne Souaya Sitton
Group Art Unit : 1634
Applicants : Bernard F. Mach et al.
Application No. : 08/484,786 Confirmation No.: 4894
Filed : June 7, 1995
For : DNA SEQUENCES CODING FOR THE DR- β CHAIN LOCUS OF THE HUMAN LYMPHOCYTE ANTIGEN COMPLEX AND POLYPEPTIDES, DIAGNOSTIC TYPING PROCESSES AND PRODUCTS RELATED THERETO

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Mail Stop AF

TERMINAL DISCLAIMER
PURSUANT TO 37 C.F.R. § 1.321(c)

Sir:

BIOMERIEUX SA, having its principal place of business at 69 280 Marcy L'Etoile, France (hereinafter "BIOMERIEUX"), represents that it is the assignee of record of the entire right, title and interest, by assignment, of the following:

United States patent application 08/484,786
(hereinafter "the '786 application"), filed June 7, 1995, for
"DNA SEQUENCES CODING FOR THE DR- β CHAIN LOCUS OF THE HUMAN
LYMPHOCYTE ANTIGEN COMPLEX AND POLYPEPTIDES, DIAGNOSTIC TYPING
PROCESSES AND PRODUCTS RELATED THERETO", as a continuation
application of United States patent application 07/902,999 (now
United States patent 5,503,976 - issued April 2, 1996), the
assignment for which was recorded on May 5, 1993 at Reel 6522,
Frame 0428, which was filed as a divisional application of
United States patent application 06/518,393 (now United States
patent 5,169,941 - issued on December 8, 1992) (hereinafter "the
'941 patent"), filed July 29, 1983, for "DNA SEQUENCES CODING FOR
THE DR- β CHAIN LOCUS OF THE HUMAN LYMPHOCYTE ANTIGEN COMPLEX
AND POLYPEPTIDES, DIAGNOSTIC TYPING PROCESSES AND PRODUCTS
RELATED THERETO", the assignment for which was recorded on
May 5, 1993 at Reel 6531, Frame 0122.

The undersigned, on behalf of BIOMERIEUX, hereby
disclaims the terminal portion of any patent granted on the
above-identified '786 application, which would extend beyond the
expiration date of the full statutory term of the '976 patent.

The undersigned, on behalf of BIOMERIEUX, agrees that
any patent so granted on the above-identified '786 application

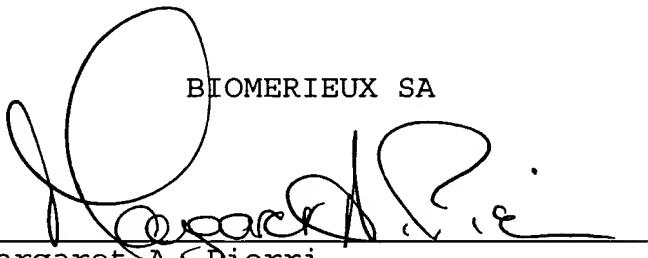
shall be enforceable only for and during such period as the legal title to said patent shall be the same as the legal title to the '976 patent, this agreement to run with any patent granted on the above-identified '786 application and to be binding upon the grantee of such patent and its successors and assigns.

The undersigned, on behalf of BIOMERIEUX, does not disclaim any terminal portion of any patent granted on the above-identified '786 application prior to December 8, 2009, the expiration of the full statutory term of the '976 patent. In the event that the '976 patent: (a) expires for failure to pay a maintenance fee, (b) is held unenforceable, (c) is found invalid, (d) is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a) or (b), (e) has all claims cancelled by a reexamination certificate, or (f) is otherwise terminated prior to expiration of its full statutory term, except for the separation of legal title stated above.

The undersigned hereby states and certifies that:

1. She is an attorney of record in the above-identified '786 application, as well as the '976 patent, and is authorized to act on behalf of assignee corporation in connection with said application; and

2. The relevant evidentiary documents have been reviewed and, to the best of the undersigned's and assignee's knowledge and belief, title in and to the above-identified '786 application, is in assignee.

BY: 
Margaret A. Pierri
Registration No. 30,709
Attorney for Applicant and Assignee
c/o FISH & NEAVE
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020
Tel.: (212) 596-9000
Fax.: (212) 596-9090

Date: April 6, 2004

TAB B

MACH2/CON

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patentees : Bernard F. Mach et al.
Patent No. : 6,818,393 B1
Issued : November 16, 2004
On Application No. : 08/484,786 Confirmation No. : 4894
Filed : June 7, 1995
For : DNA SEQUENCES CODING FOR THE DR BETA-
CHAIN LOCUS OF THE HUMAN LYMPHOCYTE
ANTIGEN COMPLEX AND POLYPEPTIDES,
DIAGNOSTIC TYPING PROCESSES AND
PRODUCTS RELATED THERETO
Group Art Unit : 1634
Examiner : Jehanne Souaya Sitton

New York, New York
January 24, 2005

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

DECLARATION OF MARGARET A. PIERRI

I, MARGARET A. PIERRI, declare that:

1. I am a partner in the Fish & Neave IP Group of Ropes & Gray LLP
(formerly Fish & Neave), attorneys of record in the above-identified application. I am an

attorney of record in this application. This declaration is filed in support of patentees' Request under 37 C.F.R. § 1.323 for Certificate of Correction, submitted concurrently herewith.

2. Upon information and belief, I believe that as of at least March 17, 2003, to the present time, the system employed by employees of the Fish & Neave IP Group of Ropes & Gray to manage word processing and electronic mail documents was and is iManage infoRite ("iManage"). In iManage, the history of the work done in connection with a particular document may be viewed by selecting a tab labeled "History" at the bottom of the iManage screen. Among other things, the iManage history identifies each user of the document, each type of activity performed, and the date and time when each activity was performed.

3. I have reviewed the Terminal Disclaimer filed on April 6, 2004 in the above-identified application ("the '393 Terminal Disclaimer"). I have also reviewed the iManage histories of two iManage documents associated with the '393 Terminal Disclaimer. Based on my review of these items, I believe that the reference to "December 8, 2009" on page 3, line 9 of the '393 Terminal Disclaimer is the result of a typographical or clerical error made during the drafting of the '393 Terminal Disclaimer.

4. In April 2004, Shawn-Marie Mayrand, a former Fish & Neave associate, was the associate working on the above-identified application. Ms. Mayrand worked in the Fish & Neave Washington, D.C. office and had the relevant application files in that office. On April 5, 2004, Ms. Mayrand drafted the '393 Terminal Disclaimer in the Washington, D.C. office for my signature. On April 6, 2004, my secretary printed out the '393 Terminal Disclaimer in our New York office, so that it could be filed by our Patent Department in New York.

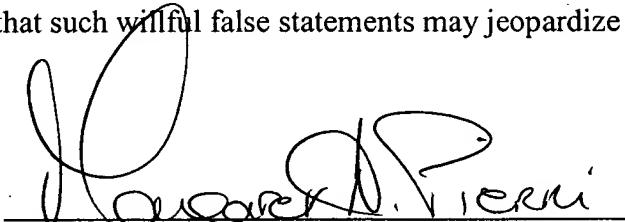
5. The iManage document number for the ‘393 Terminal Disclaimer is 20,451. A computer print-out of the complete iManage history for this document is attached as Exhibit 1. Page 3 of Exhibit 1 shows that Ms. Mayrand (indicated by the initials “SMM”) created (indicated by the word “create”) the ‘393 Terminal Disclaimer document (which was ultimately filed on April 6, 2004) on April 5, 2004 at 8:05 AM. Page 1 of Exhibit 1 shows that my secretary, Donna Prince, printed the ‘393 Terminal Disclaimer on April 6, 2004.

6. Upon information and belief, I believe that Ms. Mayrand had previously drafted a terminal disclaimer for Application No. 08/486,804, which is related to the above-identified application. Because the ‘804 application was ultimately abandoned, this related terminal disclaimer (“the ‘804 terminal disclaimer”) was never filed. A computer print-out of the draft ‘804 terminal disclaimer is attached as Exhibit 2.

7. The iManage document number for the ‘804 terminal disclaimer is 933,640. A computer print-out of the complete iManage history for this document is attached as Exhibit 3. Page 2 of Exhibit 3 shows that Ms. Mayrand (again indicated by the initials “SMM”) created the ‘804 terminal disclaimer document on March 17, 2003. Page 1 of Exhibit 3 shows that Ms. Mayrand copied the ‘804 terminal disclaimer document on April 5, 2004 at 8:05 AM. Because the date and time when Ms. Mayrand copied the ‘804 terminal disclaimer matches the date and time when the ‘393 Terminal Disclaimer was created (see paragraph 5, above), and because the text of the two documents is extremely similar, I believe that Ms. Mayrand used the ‘804 terminal disclaimer as a template for the ‘393 Terminal Disclaimer.

8. The '804 terminal disclaimer would have disclaimed the terminal portion of any patent granted that would extend beyond the calendar date of the expiration of related U.S. Patent 5,169,941 ("the '941 patent"), which is December 8, 2009 (see Exhibit 2, page 2, second paragraph and page 3, first full paragraph). Upon information and belief, I believe that after Ms. Mayrand used the '804 terminal disclaimer as a template for the '393 Terminal Disclaimer, she revised the '393 Terminal Disclaimer to refer to U.S. Patent 5,503,976 ("the '976 patent") instead of the '941 patent. Upon information and belief, I believe that Ms. Mayrand inadvertently neglected to replace the expiration date of the '941 patent, December 8, 2009, with the expiration date of the '976 patent, April 2, 2013. For these reasons, I believe that the '393 Terminal Disclaimer's reference to the date December 8, 2009, instead of the date April 2, 2013, is the result of a typographical or clerical error made during its preparation.

9. The undersigned declares further that all statements made herein of her own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of United States Patent 6,818,393.



Margaret A. Pierri (Reg. No. 30,709)

Signed this 24th day of January 2005
in New York, New York.

EXHIBIT 1

MANAGE - [iManage Desktop]

File Login Search Document Options Favorites Portable Help

20,451 1 SMM PFRM MACH2ICON: Terminal Disclaimer (4/20/04) PRTFINAL DC 28K

Manage Databases Checkout Docs Worklist Search History

Search 1 Search 2 Search 3 Search 4

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DMP	WINWORD	Print	4/6/2004 10:26:01 AM	0	4
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DMP	WINWORD	Checkin	4/6/2004 9:35:19 AM	170	0
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SMM	MANAGE32	Checkout	4/6/2004 8:49:39 AM	0	0
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- Private Saved
- Public Saved
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- PA

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History - Document: 20451_1.DOC (MACH2/CON: Terminal Disclaimer (4/20/04))

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NYF... NRY... Ready

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68 Items

EXHIBIT 2



Docket No. MACH2/DIV2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Examiner : Ronald B. Schwadron
Group Art Unit : 1644
Applicants : Bernard F. Mach et al.
Application No. : 08/486,804 Confirmation No.: 7047
Filed : June 7, 1995
For : DNA SEQUENCES CODING FOR THE DR- β CHAIN
LOCUS OF THE HUMAN LYMPHOCYTE ANTIGEN
COMPLEX AND POLYPEPTIDES, DIAGNOSTIC TYPING
PROCESSES AND PRODUCTS RELATED THERETO

Hon. Commissioner for Patents
P.O. Box 2327
Arlington, Virginia 22202

TERMINAL DISCLAIMER
PURSUANT TO 37 C.F.R. § 1.321(c)

Sir:

BIOMERIEUX SA, having its principal place of business at 69
280 Marcy L'Etoile, France (hereinafter "BIOMERIEUX"), represents that
it is the assignee of record of the entire right, title and interest,
by assignment, of the following:

United States patent application 08/486,804 (hereinafter "the '804 application"), filed June 7, 1995, for "DNA SEQUENCES CODING FOR THE DR- β CHAIN LOCUS OF THE HUMAN LYMPHOCYTE ANTIGEN COMPLEX AND POLYPEPTIDES, DIAGNOSTIC TYPING PROCESSES AND PRODUCTS RELATED THERETO", as a divisional application of United States patent application 07/902,999 (now United States patent 5,503,976 - issued April 2, 1996), the assignment for which was recorded on May 5, 1993 at Reel 6522, Frame 0428, which was filed as a divisional application of United States patent application 06/518,393 (now United States patent 5,169,941 - issued on December 8, 1992) (hereinafter "the '941 patent"), filed July 29, 1983, for "DNA SEQUENCES CODING FOR THE DR- β CHAIN LOCUS OF THE HUMAN LYMPHOCYTE ANTIGEN COMPLEX AND POLYPEPTIDES, DIAGNOSTIC TYPING PROCESSES AND PRODUCTS RELATED THERETO", the assignment for which was recorded on May 5, 1993 at Reel 6531, Frame 0122.

The undersigned, on behalf of BIOMERIEUX, hereby disclaims the terminal portion of any patent granted on the above-identified '804 application, which would extend beyond the expiration date of the full statutory term of the '941 patent.

The undersigned, on behalf of BIOMERIEUX, agrees that any patent so granted on the above-identified '804 application shall be enforceable only for and during such period as the legal title to

said patent shall be the same as the legal title to the '941 patent, this agreement to run with any patent granted on the above-identified '804 application and to be binding upon the grantee of such patent and its successors and assigns.

The undersigned, on behalf of BIOMERIEUX, does not disclaim any terminal portion of any patent granted on the above-identified '804 application prior to December 8, 2009, the expiration of the full statutory term of the '941 patent. In the event that the '941 patent: (a) expires for failure to pay a maintenance fee, (b) is held unenforceable, (c) is found invalid, (d) is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a) or (b), (e) has all claims cancelled by a reexamination certificate, or (f) is otherwise terminated prior to expiration of its full statutory term, except for the separation of legal title stated above.

The undersigned hereby states and certifies that:

1. She is an attorney of record in the above-identified '840 application, as well as the '941 patent, and is authorized to act on behalf of assignee corporation in connection with said application; and

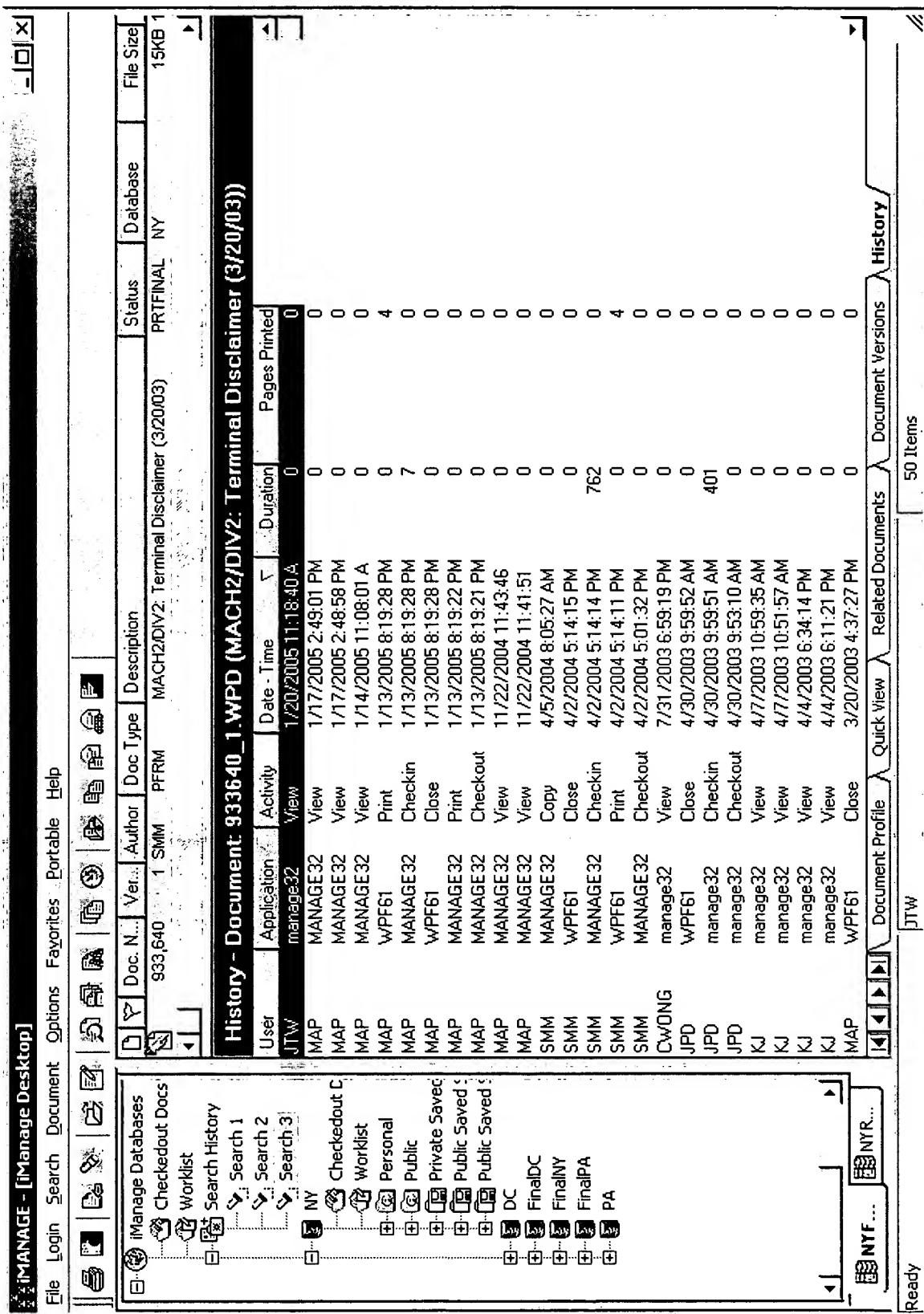
2. The relevant evidentiary documents have been reviewed and, to the best of the undersigned's and assignee's knowledge and belief, title in and to the above-identified '804 application, is in assignee.

BIOMERIEUX SA

BY: Margaret A. Pierri
Registration No. 30,709
Attorney for Applicant and Assignee
c/o FISH & NEAVE
1251 Avenue of the Americas
New York, New York 10020
Tel.: (212) 596-9000

Date: _____

EXHIBIT 3



Ready

iMANAGE - [iManage Desktop]

File Login Search Document Options Favorites Portable Help

Checkouts | Worklist | Search History | Search 1 | Search 2 | Search 3 | NY | Checkedout Docs | Worklist | Manage Databases

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MAP	manage32	Changed P	3/20/2003 4:29:10 PM	0	0
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SMM	manage32	Checkout	3/20/2003 3:31:44 PM	0	0
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SMM	manage32	Checkin	3/19/2003 7:01:47 PM	132	0
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SMM	manage32	Checkin	3/17/2003 5:56:25 PM	311	0
SMM	w/PF61	Print	3/17/2003 5:56:24 PM	0	6
SMM	manage32	Checkout	3/17/2003 5:51:14 PM	0	0
SMM	manage32	Create	3/17/2003 5:51:13 PM	0	0

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TAB C

BAYER AG and BAYER CORPORATION, Plaintiffs-Appellees, v. CARLSBAD TECHNOLOGY, INC., Defendant-Appellant.

02-1077

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

298 F.3d 1377; 2002 U.S. App. LEXIS 16710; 64 U.S.P.Q.2D (BNA) 1045

August 14, 2002, Decided

SUBSEQUENT HISTORY: [**1] Rehearing and Rehearing En Banc Denied September 23, 2002, Reported at: *2002 U.S. App. LEXIS 21335*.

PRIOR HISTORY:Appealed from: United States District Court for the Southern District of California Senior Judge Rudi M. Brewster.

DISPOSITION: AFFIRMED.

CASE SUMMARY:

PROCEDURAL POSTURE: Plaintiff patentees sued defendant competitor, in the United States District Court for the Southern District of California, asserting that their patent on ciprofloxacin was valid until December 9, 2003. The competitor counterclaimed that the ciprofloxacin claims in the patent would expire on October 1, 2002. The parties cross-moved for summary judgment. The competitor appealed denial of its motion and summary judgment for the patentees.

OVERVIEW: The subject matter of the patent in question included the antibiotic ciprofloxacin. The patentees also obtained two related patents covering ciprofloxacin which were issued earlier in time. After another competitor asserted that the subject patent was invalid for double patenting, the patentees filed a terminal disclaimer with the United States Patent and Trademark Office (PTO). Though specifying an expiration date of October 1, 2002, the disclaimer tied termination to the earlier of the termination dates of the related patents. Subsequently, *35 U.S.C.S. § 154* was amended to extend patent terms to 20 years, thus extending the term of the earlier to expire related patent

to December 9, 2003 (20 years from filing the patent application). On this unanticipated occurrence, the patentees promptly sought to change their disclaimer to extend the expiration date, which the PTO did. The court of appeals agreed with the PTO and the district court that the amendment to § 154 automatically extended the termination date of the subject patent from October 1, 2002 to December 9, 2003. The patentees' prompt action to change the disclaimer precluded any prejudice to the competitor or the public.

OUTCOME: The court of appeals affirmed the judgment of the district court.

LexisNexis(R) Headnotes

Patent Law > U.S. Patent & Trademark Office Prosecution Procedures > Examination of Applications [HN1] See *37 C.F.R. § 1.182* (2002).

Civil Procedure > Summary Judgment > Summary Judgment Standard

[HN2] The United States Court of Appeals for the Federal Circuit reviews a district court's grant of summary judgment without deference.

Civil Procedure > Summary Judgment > Summary Judgment Standard

[HN3] In considering a motion for summary judgment, a court must decide if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. *Fed. R. Civ. P.*

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64 U.S.P.Q.2D (BNA) 1045

56(c). In making this determination, the court views the record in a light most favorable to the non-moving party.

Patent Law > Infringement > Exclusive Rights
[HN4] See 35 U.S.C.S. § 154(a)(2).

Patent Law > Infringement > Exclusive Rights
[HN5] See 35 U.S.C.S. § 154(c)(1).

Patent Law > Infringement > Exclusive Rights
[HN6] See 60 Fed. Reg. 20,195, 20,207 (Apr. 25, 1995).

Patent Law > U.S. Patent & Trademark Office Prosecution Procedures > Examination of Applications
[HN7] 35 U.S.C.S. § 253, which permits filing of a terminal disclaimer and "dedication to the public" of the terminal part of the term, does not include a mechanism for withdrawal or amendment of a terminal disclaimer. Under § 253, the United States Patent and Trademark Office considers the terminal disclaimer part of the original patent.

Administrative Law > Judicial Review > Standards of Review > Standards Generally

[HN8] Where an agency's interpretation of its own regulation is reasonable, it attracts substantial judicial deference.

Patent Law > Jurisdiction & Review > Standards of Review

[HN9] Federal courts are obligated by clear United States Supreme Court precedent to give deference to the United States Patent and Trademark Office's own interpretation of its regulations.

COUNSEL: Fred H. Bartlit, Jr., Bartlit Beck Herman Palenchar & Scott, of Chicago, Illinois, argued for plaintiffs-appellees. With him on the brief were Mark L. Levine and Sean W. Gallagher. Of counsel on the brief were Charles W. Bradley and Stanley L. Amberg, Orrick, Herrington & Sutcliffe LLP, of New York, New York. Also of counsel on the brief were Bruce R. Genderson, Margaret A. Keeley, and Aaron P. Maurer, Williams & Connolly LLP, of Washington, DC.

Gary M. Hnath, Venable, Baetjer, Howard & Civiletti, LLP, of Washington, DC, argued for defendant-appellant. With him on the brief was Fei-Fei Chao.

JUDGES: Before RADER, GAJARSA, and PROST, Circuit Judges.

OPINIONBY: RADER

OPINION: [*1378] RADER, Circuit Judge.

On summary judgment, the United States District Court for the Southern District of California held that the expiration date of U.S. Patent No. 4,670,444 (the '444 patent) is December 9, 2003. Because the district court correctly concluded as a matter of law that the disclaimed term of the '444 patent was "due to" U.S. Patent No. 4,544,658, whose expiration date [**2] the Uruguay Round Agreements Act (URAA) amendments automatically changed from October 1, 2002 to December 9, 2003, this court affirms.

I.

Bayer AG and Bayer Corporation (collectively Bayer) filed a patent application on May 29, 1984 that ultimately issued as the '444 patent on June 2, 1987. The subject matter of the '444 patent includes the antibiotic ciprofloxacin sold by Bayer under the brand name CIPRO (R). Bayer also obtained two related patents covering ciprofloxacin: U.S. Patent No. 4,544,658 issued on October 1, 1985 (the Peterson '658 patent) and U.S. Patent No. 4,556,658 issued on December 3, 1985 (the Grohe '658 patent).

In December 1991, Barr Laboratories, Inc. (Barr) notified Bayer of Barr's Abbreviated New Drug Application (ANDA) submission to the Food and Drug Administration (FDA). Barr alleged that the '444 patent was invalid and unenforceable due to obviousness, obviousness-type double patenting, and inequitable conduct. In response, Bayer filed an infringement suit against Barr in the United States District Court for the Southern District of New York. To counter Barr's allegation of double patenting of the '444 patent over the two '658 patents, Bayer filed a terminal [**3] disclaimer with the United States Patent and Trademark Office (PTO). *Bayer AG v. Barr Lab., Inc.*, 798 F. Supp. 196, 24 U.S.P.Q.2D (BNA) 1864 (S.D.N.Y. 1992).

On February 21, 1992, Bayer disclaimed "the terminal part of U.S. Patent No. 4,670,444 which extends beyond October 01, 2002, the earlier of the expiration dates of U.S. Patent Nos. 4,544,658 (issued October 01, 1985) and 4,556,658 (issued December 03, 1985)." Terminal Disclaimer filed February 21, 1992 (Terminal Disclaimer). This disclaimer language is the source of the present dispute. The April 21, 1992, issue of the PTO's Official Gazette carried a notice of the disclaimer stating: "The term of this patent subsequent to October 1, 2002, has been disclaimed."

In 1994, the URAA "harmonized the term provision of United States patent law with that of our leading trading partners which grant a patent term of 20 years from the date of filing of the patent application." *Merck & Co. v. Kessler*, 80 F.3d 1543, 1547, 38 U.S.P.Q.2D (BNA) 1347, 1349 (Fed. Cir. 1996). The URAA took effect on June 8, 1995, changing the patent term from

seventeen years from the date of issuance to twenty years from the date of filing [**4] of the patent application. 35 U.S.C. § 154(a)(2) (2000). In addition, § 154(c)(1) allows "the greater of the 20-year term as provided in subsection (a), or 17 years from grant, subject to any terminal disclaimers." Id. § 154(c)(1). Consequently, the expiration date of the Peterson '658 patent changed from October 1, 2002 (seventeen years from grant) to December 9, 2003 (twenty years from filing of application) by operation of law.

[*1379] On July 10, 1995, Bayer sought to reflect the change that the URAA made on the term of the '444 patent by submitting an "amended terminal disclaimer" and a "communication submitting amended terminal disclaimer." Bayer requested the PTO amend the terminal disclaimer filed February 21, 1992 with new wording that "disclaims the terminal part . . . which would extend beyond the earlier of the expiration dates of the full statutory term . . . of U.S. Patent Nos. 4,544,658 . . . and 4,556,658" or, alternatively, to consider the communication a petition. The amended terminal disclaimer did not recite a specific date, but only referred to the expiration dates of the two '658 patents.

In view of the URAA, the PTO found Bayer's original [**5] disclaimer ambiguous in that "it sets forth two (2) dates beyond which the terminal part of the ['444 patent] is disclaimed: October 1, 2002, and December 9, 2003." Decision on petition, Application No. 06/614,923, at 5 (Jan. 31, 1996) (Decision). The PTO responded that its rules of practice did not permit withdrawal of a terminal disclaimer in favor of an amended terminal disclaimer. Nonetheless, in considering Bayer's request as a petition under its discretionary authority, * the PTO stated:

In view of the ambiguity in the terminal disclaimer filed February 21, 1992 created by the changes to 35 U.S.C. § 154(c)(1) contained in Public Law 103-465, Office records will be changed to indicate that the term of the above-identified patent subsequent to December 9, 2003, the later of the two (2) dates set forth in the terminal disclaimer filed on February 21, 1992, has been disclaimed.

Id.

* The Patent and Trademark Office (PTO) treated Bayer's communication as a petition under 37 C.F.R. § 1.182. Decision, at 1. 37 C.F.R. § 1.182 (2002) states: [HN1] "All situations not specifically provided for in the regulations of this

part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h)."

[**6]

In April 2001, Carlsbad Technology, Inc. (CTI) notified Bayer of its ANDA on ciprofloxacin. Bayer filed suit in the district court in May 2001, asserting that the '444 patent on ciprofloxacin was valid until December 9, 2003. CTI counterclaimed that the ciprofloxacin claims in the '444 patent expire on October 1, 2002. The parties dispute whether the inclusion of the "October 01, 2002" date in the February 21, 1992 terminal disclaimer created an ambiguity as to the relationship between the '444 patent and the two '658 patents. Bayer and CTI cross-moved for summary judgment. The district court denied CTI's motion and granted summary judgment in favor of Bayer. *Bayer AG v. Carlsbad Tech., Inc.*, 2001 U.S. Dist. LEXIS 24487, Civ. No. 01-867-B (LSP), slip op. at 11 (S.D. Cal. Nov. 1, 2001) (Summary Judgment). CTI timely appealed to this court, which has jurisdiction under 28 U.S.C. § 1295(a)(1).

II.

[HN2] This court reviews a district court's grant of summary judgment without deference. *Johns Hopkins Univ. v. Cellpro, Inc.*, 152 F.3d 1342, 1353, 47 U.S.P.Q.2D (BNA) 1705, 1713 (Fed. Cir. 1998). [HN3] This court must decide "if the pleadings, depositions, answers to interrogatories, and admissions [**7] on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c); *Celotex Corp. v. Catrett*, 477 U.S. 317, 322, 91 L. Ed. 2d 265, 106 S. Ct. 2548 (1986). In making this determination, this court views the record in a light most favorable to the non-moving party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255, 91 L. Ed. 2d 202, 106 S. Ct. 2505 (1986); *C.R. Bard, Inc. v. Advanced Cardiovascular Sys., Inc.*, 911 F.2d 670, 672-73, 15 U.S.P.Q.2D (BNA) 1540, 1542-43 (Fed. Cir. 1990).

CTI does not dispute the facts of this case. Rather, it challenges the district court's application of the URAA to Bayer's original terminal disclaimer which upheld the PTO's determination that the '444 patent expires on December 9, 2003. CTI asserts that the 1992 disclaimer clearly and unambiguously fixed the '444 patent's expiration date to October 1, 2002. CTI notes that the

PTO published the October 2002 date in the Gazette, indicating that the disclaimer set the expiration date for October 1, 2002.

Title 35 of the United States [**8] Code as amended in light of the URAA, states:

[HN4] (a)(2) Term. Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed.

[HN5] (c)(1) Determination. The term of a patent that is in force on or that results from an application filed before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act shall be the greater of the 20-year term as provided in subsection (a), or 17 years from grant, subject to any terminal disclaimers.

35 U.S.C. §§ 154 (a)(2) and (c)(1). In response to public comments on its rules to implement the new twenty-year term, the PTO stated:

[HN6] A patent that is in force on June 8, 1995, or a patent that issues after June 8, 1995, on an application filed before June 8, 1995, is automatically entitled to the [**9] longer of the 20-year patent term measured from the earliest U.S. effective filing date or 17 years from grant. This is automatic by operation of law. Patentees need not make any election to be entitled to the longer term.

Changes to Implement 20-year Patent Term and Provisional Applications, *60 Fed. Reg. 20,195, 20,207* (April 25, 1995) (emphasis added).

In the present case, Bayer's February 21, 1992 terminal disclaimer recites in pertinent part:

Bayer . . . disclaims the terminal part of U.S. Patent No. 4,670,444 which extends beyond October 01, 2002, the earlier of the expiration dates of U.S. Patent Nos. 4,544,658 (issued October 01, 1985) and 4,556,658 (issued December 03, 1985), and hereby agrees that U.S. Patent No. 4,670,444 shall be enforceable only for and during such period that legal title to U.S. Patent No. 4,670,444 shall be the same as legal title to U.S. Patent Nos. 4,544,658 and 4,556,658.

(Emphases added.) This disclaimer expressly sets the expiration date of the '444 patent at the "earlier of the expiration dates" of the two '658 patents. Before the URAA amendments took effect on June 8, 1995, the earlier of the [**10] expiration dates of the two '658 patents was October 1, 2002, i.e., seventeen years from date of issuance of the Peterson '658 patent. Hence, when filed in 1992, the language of the terminal disclaimer set the expiration date for the '444 patent for October 2002.

[*1381] When the URAA amendments took effect on June 8, 1995, however, the earlier of the two expiration dates became December 9, 2003, i.e., twenty years from the date of filing of the Peterson '658 patent. *35 U.S.C. § 154(a)(2)*. This extension of patent term on the Peterson '658 patent was "automatic by operation of law." *60 Fed. Reg. at 20,207*. Consequently, the terminal disclaimer of the '444 patent, as tied to the Peterson '658 patent, moved the expiration date of the '444 patent automatically to December 9, 2003. The disclaimer also mentioned the October 2002 date. In that situation, the PTO detected an ambiguity because the disclaimer now contained two dates: October 1, 2002 and December 9, 2003. The district court correctly relied on the PTO's analysis of the law and of the language of the original terminal disclaimer.

Although finding that the URAA amendments created an ambiguity [**11] in Bayer's original terminal disclaimer, the PTO declined Bayer's request to withdraw the original disclaimer and substitute a new one. The PTO explained that the rules of practice did not provide for the withdrawal of a terminal disclaimer. Decision, at 3. [HN7] Section 253, which permits filing of a terminal disclaimer and "dedication to the public" of the terminal part of the term, does not include a mechanism for withdrawal or amendment of a terminal disclaimer. *35 U.S.C. § 253*. Under *35 U.S.C. § 253*, the PTO considers the terminal disclaimer part of the original patent. The PTO also noted that the clarification of the disclaimed date was not the correction of a clerical

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or typographical mistake under 35 U.S.C. § 255 and 37 C.F.R. § 1.323. Decision, at 2-3.

Nonetheless, because 35 U.S.C. § 154(a)(2) automatically extended the term of the Peterson '658 patent by operation of law, 60 Fed. Reg. at 20,207, the PTO corrected its records to indicate that Bayer had disclaimed the term of the '444 patent beyond December 9, 2003 in accordance with [**12] 35 U.S.C. § 154(c)(1). Decision, at 6. The district court correctly sustained the PTO's actions as a proper exercise of its authority under 37 C.F.R. § 1.182.

The district court properly accorded deference to the PTO's implementing regulations and to the PTO's interpretative "Decision", which it found complied with 35 U.S.C. §§ 154 (a)(2) and (c)(1), in accordance with *Skidmore v. Swift & Co.*, 323 U.S. 134, 140, 89 L. Ed. 124, 65 S. Ct. 161 (1944). See also *Merck*, 80 F.3d at 1550; *United States v. Cleveland Indians Baseball Co.*, 532 U.S. 200, 220, 149 L. Ed. 2d 401, 121 S. Ct. 1433 (2001) [HN8] ("Because [the agency's] interpretation [of its own regulation] is reasonable, it attracts substantial judicial deference."); *Dethmers Mfg. v. Automatic Equip. Mfg.*, 272 F.3d 1365, 1379, 60 U.S.P.Q.2D (BNA) 1929, 1939 (Fed. Cir. 2001) (Dyk, J., concurring-in-part and dissenting-in-part) [HN9] ("We are obligated by clear Supreme Court precedent to give deference to the PTO's own interpretation of its regulations."). The PTO thoroughly considered the effect of the URAA on this terminal disclaimer and gave persuasive reasons for correcting [**13] its records to reflect the December 2003 expiration date for the '444 patent.

Beyond deference to the PTO analysis, the district court also examined the meaning and effect of the URAA. As noted, the URAA states that the "term of a patent . . . shall be the greater of the 20-year term as provided in subsection (a), or 17 years from grant." 35 U.S.C. § 154(c)(1) (2000). This language mandates the automatic substitution of a later expiration date for the prior expiration date of the Peterson '658 patent. Because Bayer linked its terminal disclaimer to the expiration date of the Peterson '658 patent, the terminal disclaimer date also automatically shifted to December 2003.

[*1382] As the district court noted, the Senate Report on the URAA confirms this meaning of the statutory language as applied to terminal disclaimers:

A patent whose term has been under section 235 of Title 35 due to another patent on an invention that is not patentably distinct from but was owned by or subject to an obligation of assignment to the same person shall expire on the date of the other patent. A

patent whose term has been disclaimed under section 235 independent of another [**14] patent shall be reduced by the length of the originally disclaimed period.

Summary Judgment, at 4-5 (quoting S. Rep. No. 103-412, at 229 (1994)) (emphases added). Applying this explanation of the statutory language, the district court found: "Bayer used language indicating interdependence between several patents." Id. For example, the disclaimer recites "the earlier of the expiration dates of . . ." which modifies the date by its source. Id. The disclaimer also states that Bayer "agrees" that the '444 patent "shall be enforceable only for and during such period that legal title to U.S. Patent No. 4,670,444 shall be the same as legal title to U.S. Patent Nos. 4,544,658 and 4,556,658." Id. at 10. Accordingly, the court concluded that the disclaimed term of the '444 patent was "due to" the Peterson '658 patent, rather than "independent of" that patent. Id. This court discerns no error in the trial court's conclusion.

CTI argues that the trial court should have resolved any ambiguity in the terminal disclaimer in favor of the public. CTI argues that Bayer renounced its rights in the '444 patent after October 1, 2002, and thereby dedicated part of the term of [**15] that patent to the public. According to CTI, the public was entitled to rely on Bayer's disclaimer.

Bayer's original terminal disclaimer recited the October 1, 2002 date as a correct application of the law then in effect. When the URAA altered patent terms, Bayer acted in a timely manner to rectify any ambiguity. Bayer petitioned the PTO to withdraw the disclaimer within one month of the adoption of the URAA amendments. Moreover, the PTO's decision on Bayer's petition became part of the public record on January 31, 1996, more than five years before CTI filed its ANDA in April 2001. Hence, CTI, as well as the public, undisputedly had access to the PTO's interpretation of Bayer's original terminal disclaimer at the time CTI filed its ANDA. Thus, Bayer's prompt action precluded any prejudice to CTI or the public.

Finally, as Bayer points out, "no patentee could have anticipated the URAA patent extension" at the time Bayer filed its terminal disclaimer in 1992. The "October 01, 2002" date was simply the date of expiration of the Peterson '658 patent as calculated under then-existing law. Furthermore, Bayer disclaimed part of the '444 patent term pursuant to its ANDA related suit against [**16] Barr to defend against Barr's allegation that the '444 patent was invalid for double patenting over the two '658 patents. Thus, in context, Bayer intended to disclaim the term from the "earlier of the expiration dates of U.S.

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Patents Nos. 4,544,658 (issued October 1, 1985) and 4,556,658 (issued December 3, 1985)." Terminal Disclaimer.

As the district court correctly noted: "Bayer thereby voluntarily abandoned the protected term on the '444 patent to the extent that it exceeded the earlier patents, and agreed to enforce the '444 patent only up to the date on which the Peterson '658 patent would expire." Summary Judgment, at 2. Because the URAA amendments automatically changed the expiration date of the Peterson '658 patent from October 1, 2002 to December 9, 2003, the [*1383] expiration date of the '444 patent, which is contingent upon the expiration date

of the Peterson '658 patent, also changed simultaneously to December 9, 2003.

III.

In sum, the district court properly upheld the PTO's determination that the expiration date of the '444 patent as it relates to ciprofloxacin is December 9, 2003.

COSTS

Each party shall bear its own costs.

AFFIRMED.

Bayer AG v. Carlsbad Tech., Inc. (Bayer Corp.), 298 F.3d 1377, 2002 U.S. App. LEXIS 16710, 64 U.S.P.Q.2d (BNA) 1045 (Fed. Cir. 2002)

SHEPARD'S(R) Signal: Citing Refs. With Analysis Available

Restrictions: *Unrestricted*

FOCUS(TM) Terms: *No FOCUS terms*

Print Format: *FULL*

Citing Ref. Signal: *Hidden*

SHEPARD'S SUMMARY

Shepard's FULL Summary:

No negative subsequent appellate history.

Citing References:

Citing Decisions: Citing decisions with no analysis assigned (3)

Other Sources: Law Reviews (1), Statutes (1), Treatises (8)

PRIOR HISTORY (0 citing references)

(CITATION YOU ENTERED):

Bayer AG v. Carlsbad Tech., Inc. (Bayer Corp.), 298 F.3d 1377, 2002 U.S. App. LEXIS 16710, 64 U.S.P.Q.2d (BNA) 1045 (Fed. Cir. 2002)

SUBSEQUENT APPELLATE HISTORY (1 citing reference)

1. Rehearing denied by, Rehearing, en banc, denied by:

Bayer AG v. Carlsbad Tech., Inc., 2002 U.S. App. LEXIS 21335 (Fed. Cir. Sept. 23, 2002)

CITING DECISIONS (3 citing decisions)

FEDERAL CIRCUIT - COURT OF APPEALS

2. Cited by:

Eli Lilly & Co. v. Bd. of Regents of the Univ. of Wash., 334 F.3d 1264, 2003 U.S. App. LEXIS 13508, 67 U.S.P.Q.2d (BNA) 1161 (Fed. Cir. 2003)
334 F.3d 1264 p.1269

FEDERAL CLAIMS COURT

3. Cited by:

Charter F.S.B. v. United States, 54 Fed. Cl. 120, 2002 U.S. Claims LEXIS 262 (2002)
54 Fed. Cl. 120 p.126

PATENT & TRADEMARK OFFICE

4. Cited by:

In re Dowden, 2003 TTAB LEXIS 445 (Trademark Trial & App. Bd. Aug. 8, 2003)
2003 TTAB LEXIS 445

ANNOTATED STATUTES (1 Citing Statute)

5. 35 USCS @ 154

LAW REVIEWS AND PERIODICALS (1 Citing Reference)

6. ARTICLE: TREATING THE LEGAL SIDE EFFECTS OF CIPRO : A REEVALUATION OF COMPENSATION RULES FOR GOVERNMENT TAKINGS OF PATENT RIGHTS, 40 Am. Bus. L.J. 125 (2002)

TREATISE CITATIONS (8 Citing Sources)

7. 3-9 Chisum on Patents Supp. to @ 9.04

8. 5-16 Chisum on Patents Supp. to @ 16.04

9. 11A Chisum on Patents PART I (Continued from Volume 11) (Cont)TOPICAL OUTLINE WITH ABSTRACTS.syn

10. 11A Chisum on Patents Supp. to 1600

11. 12 Chisum on Patents @ 3000 (Cont)

12. 12A Chisum on Patents @ 5000

13. 1-1 PATENT LAW DIGEST 5100

14. 1-3 PATENT LAW DIGEST Scope

TAB D



UNITED STATES PATENT AND TRADEMARK OFFICE
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 45

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P.O. BOX 3026
MALVERN, PA 19355

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OFFICE OF PLEADINGS
A/CORRESPONDENCE

In re Patent No. 4,818,816 :
Issue Date: April 4, 1989 :
Application No. 07/115,593 :
Filed: October 26, 1987 :
Patentees: Maurice Petitou et al. :

ON PETITION

This is a decision on the petition under 37 CFR 1.182, filed March 11, 1996, requesting that the terminal disclaimer under 35 U.S.C. § 253 filed on October 23, 1988 be withdrawn in favor of a newly submitted terminal disclaimer.

The petition is DENIED.

BACKGROUND

A Notice of Allowance and Notice of Allowability were mailed on June 13, 1988 in the above-identified application.

A terminal disclaimer under 35 U.S.C. § 253 and 37 CFR 1.321 was voluntarily filed on October 23, 1988. The terminal disclaimer of October 23, 1988 was executed by Pierre Williams on behalf of Choay, S.A., and stated that:

Your petitioner, Choay, S.A., hereby disclaims the terminal part of any patent on the above-identified application which would extend beyond the expiration date of U.S. Patent No. 4,607,025, issued on August 19, 1986, . . .

The above-identified application issued as U.S. Patent No. 4,818,816 on April 4, 1989.

The instant petition under 37 CFR 1.182 was filed on March 11, 1996, and requests that the terminal disclaimer filed on

October 23, 1988 be withdrawn in favor of a newly submitted terminal disclaimer stating that:

Choay, S.A., hereby disclaims, except as provided below, the terminal part of the statutory term of the above-identified patent which extends beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 of U.S. Patent No. 4,607,025, issued on August 19, 1986,

STATUTE AND REGULATION

35 U.S.C. § 253 states that:

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing and recorded in the Patent and Trademark Office, and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

35 U.S.C. § 255 provides that:

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

37 CFR 1.323 provides that:

Whenever a mistake of a clerical or typographical nature or of minor character which was not the fault of the Office, appears in a patent and a showing is made that such mistake occurred in good faith, the Commissioner may, upon payment of the fee set forth in § 1.20(a), issue a certificate, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. A request for a certificate of correction of a patent involved in an interference shall comply with the requirements of this section and shall be accompanied by a motion under § 1.635.

37 CFR 1.325 provides that:

Mistakes other than those provided for in §§ 1.322, 1.323, 1.324, and not affording legal grounds for reissue or for reexamination, will not be corrected after the date of the patent.

OPINION

Petitioner (Choay, S.A.) asserts that U.S. Patent No. 4,607,025 recently expired due to failure to pay a maintenance fee. Petitioner argues that the language of the terminal disclaimer filed on October 23, 1988 might be ambiguous as to whether the "expiration date of U.S. Patent No. 4,607,025" set forth therein is measured from the full statutory term of U.S. Patent No. 4,607,025, or the actual term U.S. Patent No. 4,607,025 due to the failure to timely submit a maintenance fee. Petitioner requests that the terminal disclaimer submitted with the instant petition be substituted for the terminal disclaimer filed on October 23, 1988 to resolve this potential ambiguity.

The statutory authority for amendment or correction of an issued patent is found in title 35, chapter 25. The instant petition does not involve correction of a mistake by the Patent and Trademark Office (Office) (35 U.S.C. § 254) or correction of the named inventor (35 U.S.C. § 256). In addition, while the instant petition involves a disclaimer, 35 U.S.C. § 253 merely authorizes the filing and recording of disclaimers; it does not authorize the withdrawal of a terminal disclaimer. Finally, petitioners have not sought amendment or correction by reissue (35 U.S.C. §§ 251 and 252).

Unless a "mistake" is provided for in 37 CFR 1.322, 1.323, or 1.324, or affords legal grounds for reissue or for reexamination,

such "mistake" will not be corrected subsequent to the issuance of an application as a patent. See 37 CFR 1.325. As stated in section 1490 of the Manual of Patent Examining Procedure (MPEP) (6th Ed., Rev. 1 1995), the mechanisms to correct a patent (i.e., certificate of correction (35 U.S.C. § 255), reissue (35 U.S.C. § 251), and reexamination (35 U.S.C. § 305)) are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer. The Supreme Court has stated that, as a general principle, public policy does not favor the restoration to a patent of that which has been dedicated to the public by disclaimer. See Altoona Publix Theatres, 294 U.S. 477, 492, 24 USPQ 308, 315 (1935); see also Leggett v. Avery, 101 U.S. (11 Otto) 256, 259-60 (1879).

In any event, to withdraw the terminal disclaimer filed on October 23, 1988 and properly recorded in the above-identified patent, such action must be authorized pursuant to 35 U.S.C. § 255.

A Certificate of Correction under 35 U.S.C. § 255 and 37 CFR 1.323 is available for the correction of errors of a minor or clerical character, and does not extend to the correction of errors that would constitute new matter or would require reexamination. See In re Arnott, 19 USPQ2d 1049, 1054 (Comm'r Pats. 1991); In re Hyman, 185 USPQ 441, 442 (Sol. Pat 1975). Specifically, 35 U.S.C. § 255 requires, *inter alia*, that two specific and separate requirements be met prior to the issuance of a Certificate of Correction. The first requirement is that the mistake is: (1) of a clerical nature, (2) of a typographical nature, or (3) of minor character. The second requirement is that the correction must not involve changes that would: (1) constitute new matter or (2) would require reexamination. See Arnott 19 USPQ2d at 1052; see also MPEP 1490.

The "mistake" at issue involves the failure to specify in the terminal disclaimer filed on October 23, 1988 that petitioner does not disclaim the terminal part of the above-identified patent which extends beyond the expiration date U.S. Patent No. 4,607,025, unless such expiration date is based upon the full statutory term defined in 35 U.S.C. §§ 154 to 156 of U.S. Patent No. 4,607,025. This "mistake," however, is not one of a clerical or typographical nature; rather, it involves a substantive re-drafting of the language in the terminal disclaimer to be recorded for the above-identified patent. In addition, as this "mistake" involves altering the language concerning the expiration date of the above-identified patent (i.e., correction of this "mistake" would potentially result in changing the term of the above-identified patent), this "mistake" cannot reasonably be characterized as one of minor character. See MPEP 1490.

Since the first requirement under 35 U.S.C. § 255 is not met (i.e., the "mistake" sought to be corrected is not of the type proper for correction under 35 U.S.C. § 255), whether the withdrawal of the terminal disclaimer filed on October 23, 1988 in favor of a newly submitted terminal disclaimer would constitute new matter or require reexamination is moot. Id.

Accordingly, the Certificate of Correction is not available for the requested correction.

Assuming, arguendo, that the patent statutes authorized the withdrawal of the terminal disclaimer filed on October 23, 1988 in favor of a newly submitted terminal disclaimer, such action would not constitute an appropriate exercise of the Commissioner's discretion under 37 CFR 1.182 or 1.183 or 35 U.S.C. § 255 and 37 CFR 1.323. Granting the requested relief would operate to evade the requirements of the reissue statutes (i.e., 35 U.S.C. §§ 251 and 252). The remedial nature of reissue notwithstanding, reissue is not available to correct all errors. Specifically, it is the Office's position that reissue is not available to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent. See Ex parte Anthony, 230 USPQ 467 (Bd. App. 1982), affd, Appeal No. 84-1357 (Fed. Cir. 1985); see also MPEP 1490.

Thus, the "mistake" at issue is not provided for in 37 CFR 1.322, 1.323, or 1.324, and does not afford legal grounds for reissue or for reexamination. Therefore, the PTO will not, pursuant to 37 CFR 1.182 or 1.183, withdraw or otherwise nullify the effect of a disclaimer properly recorded in an issued patent. See 37 CFR 1.325; MPEP 1490. The PTO, however, expresses no opinion on the effect on the above-identified patent of the expiration of U.S. Patent No. 4,607,025 for failure to timely pay a maintenance fee.

CONCLUSION

For the above stated reasons, the request to withdraw the terminal disclaimer under 35 U.S.C. § 253 and 37 CFR 1.321 filed on October 23, 1988 in favor of a newly submitted terminal disclaimer is denied.

Telephone inquiries should be directed to the Office of Petitions Staff at (703) 305-9282.

The patent file is being returned to Files Repository.



Jeffrey V. Nase
Patent Legal Administrator
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

rwb/ah

cc: SETH H. JACOBS
DAVIS, HOXIE, FAITHFULL & HAPGOOD
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TAB E



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 25

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SEP 14 1998

SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS

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LARSON AND TAYLOR
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ALEXANDRIA, VIRGINIA 22314

In re Patent No: 4,346,116 :
Application No. 06/151,816 :
Filed: October 31, 1984 : DECISION DENYING PETITION
Issue date: August 24, 1982 :
Inventor: Francoise Verwaerde et al:

This is a decision on the renewed petition under 37 CFR 1.182, which now requests that the PTO "give notice to the public of the true expiration date of the patent, i.e., May 14, 1999."

The petition is DENIED.

BACKGROUND

In response to the final Office action of August 19, 1991, wherein the examiner rejected inter alia, various claims over claims 6 and 7 of copending application No. 038,711, applicants filed an amendment and a terminal disclaimer on December 21, 1981. The accompanying remarks noted:

"[t]he amendment (sic, rejection) of claims 27-34 and 37-40 as obvious variants of claims in Serial No. 038,711 is being obviated by the Terminal Disclaimer submitted herewith."

The application was allowed by the examiner in the Office communication mailed March 15, 1992, and issued August 24, 1982.

A petition filed September 11, 1997, requested under 37 CFR 1.182 that the recorded terminal disclaimer filed on December 21, 1981, be withdrawn in favor of a revised, apparently forthcoming, terminal disclaimer, and further, that a Certificate of Correction (PTO mistake) be issued to that effect. Petitioners specifically requested that the aforementioned original terminal disclaimer be replaced, in that the instant patent term, via the original terminal disclaimer, is limited to the pre "GATT-NAFTA" (Uruguay

Round Agreements Act (URAA) (1994)) expiration date for U.S. Patent No. 4,279,931 (July 21, 1998), while the latter patent now expires May 14, 1999, as was apparently to be reflected in any forthcoming terminal disclaimer. As such, petitioner asserted, the instant patent contains an erroneous date of expiration, and further, as the error in the patent is not the fault of petitioner, no fees for either the petition, or the requested Certificate of Correction, should be assessed.

The petition was dismissed in the decision of February 11, 1998.

The instant renewed petition was filed April 13, 1998.

STATUTE AND REGULATION

35 USC § 253 states that:

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

35 USC § 254 provides:

Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Commissioner may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Commissioner may issue a

corrected patent without charge in lieu of and with like effect as a certificate of correction.

35 USC § 255 states that:

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require re-examination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

37 CFR 1.182 provides that:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h).

37 CFR 1.322 provides that:

(a) A certificate of correction under 35 U.S.C. 254 may be issued at the request of the patentee or the patentee's assignee. Such certificate will not be issued at the request or suggestion of anyone not owning an interest in the patent, nor on motion of the Office, without first notifying the patentee (including any assignee of record) and affording the patentee an opportunity to be heard. When the request relates to a patent involved in an interference, the request shall comply with the requirements of this section and shall be accompanied by a motion under § 1.635.

(b) If the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form, the Commissioner may issue a corrected patent in

lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee.

37 CFR 1.321 states:

(a) A patentee owning the whole or any sectional interest in a patent may disclaim any complete claim or claims in a patent. In like manner any patentee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee and its successors or assigns. A notice of the disclaimer is published in the Official Gazette and attached to the printed copies of the specification. The disclaimer, to be recorded in the Patent and Trademark Office, must:

- (1) be signed by the patentee, or an attorney or agent of record;
- (2) identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term, will be refused recordation;
- (3) state the present extent of patentee's ownership interest in the patent; and
- (4) be accompanied by the fee set forth in § 1.20(d).

(b) An applicant or assignee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

- (1) be signed:
 - (i) by the applicant, or
 - (ii) if there is an assignee of record of an undivided part interest, by the applicant and such assignee, or
 - (iii) if there is an assignee of record of the entire interest, by such assignee, or
 - (iv) by an attorney or agent of record;

- (2) specify the portion of the term of the patent being disclaimed;
 - (3) state the present extent of applicant's or assignee's ownership interest in the patent to be granted; and
 - (4) be accompanied by the fee set forth in § 1.20(d).
- (c) A terminal disclaimer, when filed to obviate a judicially created double patenting rejection in a patent application or in a reexamination proceeding, must:
- (1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;
 - (2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and
 - (3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.
- (c) A terminal disclaimer, when filed to obviate a judicially created double patenting rejection in a patent application or in a reexamination proceeding, must:
- (1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;
 - (2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and
 - (3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.

37 CFR 1.323 states that:

Whenever a mistake of a clerical or typographical nature or of minor character which was not the fault of the Office, appears in a patent and a showing is made that such mistake occurred in good faith, the Commissioner may, upon payment of the fee set forth in § 1.20(a), issue a certificate, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. A for a certificate of correction of a patent involved in an interference shall comply with the requirements of this section and shall be accompanied by a motion under § 1.635.

OPINION

Petitioners request reconsideration in that the decision of February 11, 1998 is asserted to have failed to address the basis of the prior request filed September 11, 1997. Specifically petitioners assert, the Commissioner has authority under 37 CFR 1.182 to give notice to the public of the true expiration date of the above-captioned patent, which petitioner contends, is May 14, 1999.

The showing of record fails to adequately demonstrate that the facts of this case warrant the relief(s) requested.

The terminal disclaimer under 35 USC § 253 and 37 CFR 1.321, filed December 21, 1981, was relied upon by petitioners to overcome a rejection on the grounds of obviousness type double patenting involving the claims of commonly owned U. S. Patent No. 4,279,931 issued July 21, 1981. The terminal disclaimer was executed by Germain Roquette, on behalf of the assignee, Roquette Freres, and specified in pertinent part that:

"The said assignee does hereby disclaim and dedicate to the public the terminal portion of any United States Patent to be issued on this application beyond July 21, 1998."

While petitioners now predicate their request for withdrawal of the recorded terminal disclaimer upon a subsequent change in the term of the '931 patent, inspection of the above-quoted language in that disclaimer reveals that petitioners originally made such disclaimer contingent upon an actual date of expiration of the term of the '931 patent. That is, petitioners made the original terminal disclaimer absolute, that is, date-specific to July 21, 1998. It follows that regardless of what effect the URAA may have

subsequently had on the expiration date of the '931 patent, there is no nexus between that date and the specific expiration date as set forth in the original terminal disclaimer of record. As such, no error is apparent in the term of the original instant letters patent, as indicated by the recorded terminal disclaimer, which warrants correction. As such, it is not apparent from the record, and petitioner has not shown, on the record, how the express date certain patent expiration of July 21, 1998 given by the assignee of the entire interest, becomes May 14, 1999. Rather, as the patent was freely stated to expire on July 21, 1998 whatever effects the URAA might have had on the term of other patent, is simply immaterial to the date specific expiration of the above-captioned patent. Contrary to petitioners' contention, whatever authority may be vested under and by the patent statutes and rules of practice, such authority does not controvert the assignee's express statement of a date certain expiration of the instant patent. In other words, it is manifestly inconsistent with the express language supplied by petitioners in the above-noted terminal disclaimer to now aver that the "true expiration date" is any other than that specifically recited in the terminal disclaimer, and proclaimed to the public as part of the instant patent since its date of issuance.

It is also brought to petitioners' attention that:

"The purpose of the URAA [codified in part in 35 U.S.C. § 154] **was not to extend patent terms**, although it has that effect in some cases, but to harmonize the term provision of United States patent law with that of our leading trading partners which grant a patent term of 20 years from the date of filing of the patent application. Prior to June 8, 1995, U.S. patents had an expiration date under 35 U.S.C. Section 154 **measured as 17 years from the date the patent issued, except where terminal disclaimers were filed**. Amended section 154(a) now reads:

Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed.

35 U.S.C. § 154(a)(2) (1994).

For certain patents which were issued and for pending applications which were filed prior to June 8, 1995, a transitional provision preserves a guaranteed 17-year term, if it is longer than 20 years from filing, by the following provision:

The term of a patent that is in force on or that results from an application filed before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act shall be the greater of the 20-year term as provided in subsection (1), or 17 years from grant, subject to any terminal disclaimers.

Id. at Section 154(c)(1). Patents in the section 154(c)(1) category thus are entitled to keep or to enjoy the 17-year term from issuance of the patent or a 20-year from filing term, whichever is longer."¹ (emphasis added)

The statutory authority for amendment or correction of an issued patent is found in title 35, chapter 25. The instant petition does not involve correction of a mistake by the Patent and Trademark Office (Office) (35 USC § 254) or correction of the named inventor (35 USC § 256). In addition, while the instant petition involves a disclaimer, 35 USC § 253 merely authorizes the filing and recording of disclaimers; it does not authorize the withdrawal of a terminal disclaimer. Finally, petitioners have not sought amendment or correction by reissue (35 USC §§ 251 and 252).

Unless a "mistake" is provided for in 37 CFR 1.322, 1.323, or 1.324, or affords legal grounds for reissue or for reexamination, such "mistake" will not be corrected subsequent to the issuance of an application as a patent. See 37 CFR 1.325. As stated in section 1490 of the Manual of Patent Examining Procedure (MPEP) (6th Ed., Rev. 3 1997), the mechanisms to correct a patent (i.e., certificate of correction (35 USC § 255), reissue (35 USC § 251) and reexamination (35 USC § 305)) are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer.

¹ Merck & Co. v. Kessler, 80 F.3d 1543, 1547-1548, 38 USPQ2d 1347, 1349-1350 (Fed. Cir. 1996).

Further in this regard, the public has had fifteen (fifteen) years since the grant of the above-identified patent, to act on its facial representation that the term of this patent will expire, at the latest, on July 21, 1998. Similarly, petitioners have had, since the submission of the aforementioned terminal disclaimer on December 21, 1981, no reasonable basis to expect a term for this patent that would extend beyond July 21, 1998.

While petitioners may now consider the originally filed disclaimer to be unnecessary, or unnecessarily limiting, petitioners are, nevertheless, confronted with what has been characterized as "an unhappy circumstance", rather than a circumstance necessitating relief. See In re Jentoft, 392 F.2d 633, 639 n. 6, 157 USPQ 363, 368 n. 6 (CCPA 1968); MPEP 1490. When the question of whether or not a given set of claims in one application or patent is distinct from another set of claims in another application or patent with respect to obviousness double patenting arises, that question relates to the merits of an invention, and the appropriate remedy for resolution of that issue ultimately lies by appeal as provided by statute. See e.g. In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Petitioners had the opportunity to challenge the need for a terminal disclaimer, on appeal, but instead, freely chose to file a terminal disclaimer to avoid the rejection, during the prosecution of the application that led to the above-identified patent. Such does not afford proper legal or public policy grounds for requesting nullification of the terms of free dedication to the public contained in the previously filed terminal disclaimer by way of appeal, much less on petition. Cf. Ex Parte Anthony, 230 USPQ 467 (PBAI 1982) aff'd. No. 84-1357 (Fed. Cir. June 14, 1985).

Even assuming, *arguendo*, the relief(s) requested should be considered on petition, petitioners are reminded that, as a general rule, public policy does not favor the restoration to the patentee [applicant] of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner, e.g., intervening rights in the case of a reissue patent. See Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935). Petitioners have failed to provide a reasonable, much less any, assurance that the public interest will, or can be, protected if the relief(s) requested in this petition are given favorable consideration. In this regard, an applicant's use, and Office acceptance, of a terminal disclaimer is in the public interest because such encourages the disclosure of additional developments, the earlier filing of patent applications, and the earlier expiration of

patents whereby the inventions covered become freely available to the public. Jentoft, supra. It is brought to petitioners' attention that the principle against recapturing something that has been intentionally dedicated to the public dates back at least to Leggett v. Avery, 101 U.S. 246 (1879). As noted above, while petitioners may now consider the previously filed disclaimer to be unnecessary, or unnecessarily limiting, petitioners are, nevertheless, confronted with what has been characterized as "an unhappy circumstance", rather than a circumstance(s) necessitating relief. Jentoft at 639 n. 6, 157 USPQ at 368 n. 6.

Moreover, petitioners have made no attempt to explain their delay in presenting this petition, over two years after the implementation of the URAA. The public has thus had some two years within which to rely on the fact that, notwithstanding the URAA of 1994, and its effective date of June 8, 1995, petitioners permitted the original terminal disclaimer in this patent to continue in unabated force and effect. While petitioners should not infer that, had the instant petition been more seasonably presented, a different result might have been obtained; nevertheless, the record shows that petitioners did not diligently address the issues pertaining to the instant terminal disclaimer presented by the aforementioned URAA. Assuming, *arguendo*, that petitioners may, seasonably or otherwise, request rescission of the terminal disclaimer of record, equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable, due care and diligence. U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983).

In any event, to withdraw the recorded terminal disclaimer filed on December 21, 1981 and properly recorded in the above-identified patent, such action must be authorized pursuant to 35 USC § 255.

A Certificate of Correction under 35 USC § 255 and 37 CFR 1.323 is available for the correction of errors of a minor or clerical character, and does not extend to the correction of errors that would constitute new matter or would require reexamination. See In re Arnott, 19 USPQ2d 1049, 1054 (Comm'r Pat. 1991); In re Hyman, 185 USPQ 441, 442 (Sol. Pat. 1975). Specifically, 35 USC § 255 requires, *inter alia*, that two specific and separate requirements be met prior to the issuance of a Certificate of Correction. The first requirement is that the mistake is: (1) of a clerical nature, (2) of a typographical nature, or (3) of minor character. The second requirement is that the correction must not involve changes that would: (1) constitute new matter or (2) would

require reexamination. See Arnott 19 USPQ2d at 1052; see also MPEP 1490.

Apparently, the "mistake" at issue here involves petitioners' inclusion in the terminal disclaimer filed December 21, 1981, of a specific expiration date: July 21, 1998. However, this "mistake" is not one of a clerical or typographical nature; rather correcting this "mistake" would involve a substantive change to the recorded terminal disclaimer of record. Secondly, the "broadening" of the claims of a patent, via the attempted removal of a recorded terminal disclaimer, requires reexamination (pursuant to 35 USC § 251) of the issues raised thereby. See Anthony, supra. Further, in this regard, even while 35 USC 251 is a remedial statute, and, as such, is often liberally construed, nevertheless, there is a two year bar on any remedy that would effectuate broadening of an issued patent. See 35 USC 251. As held in Anthony, however, removal of a recorded terminal disclaimer, and the resultant "broadening" of the vertical scope (term) of the original patent, is prohibited, *inter alia*, if the attempt via reissue is not sought within two years of the patent grant. See id. at 470. It would appear to be an improper exercise of 37 CFR 1.182 to permit petitioner to regain, on petition, what petitioner could not herein regain under the remedial patent statute, which, as such, is "liberally construed." Under the facts of this case, it would be an inappropriate exercise of 37 CFR 1.182 to rescind the terminal disclaimer.

DECISION

For the reasons given above, it would be an inappropriate exercise of 37 CFR 1.182 to rescind the terminal disclaimer of record. Accordingly, the petition is granted to the extent that the previous decision has been reconsidered, but is **denied** as to rescinding the terminal disclaimer of record.

This patent file is being returned to the Files Repository.

Telephone inquiries relative to this decision should be directed to Special Projects Examiner Brian Hearn at (703) 305-1820.


Manuel A. Antonakas
Director, Office of Patent Policy Dissemination
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

TAB F



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 50

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SEP 17 1998

SPECIAL PROGRAMS OFFICE
DAB FOR PATENTS

In re Application of :
David L. Marshall :
Application No. 07/096,207 : DECISION DENYING PETITION
Filed: December 18, 1990 :
Attorney Docket No. 85-US-0050M :

This is a decision on the renewed petition filed February 2, 1998, which requests under 37 CFR 1.182 that the terminal disclaimer filed on July 20, 1993 as part of a petition under 37 CFR 1.183 and 1.137(b), which Terminal Disclaimer was accepted for the term of forty three (43) months, be withdrawn in favor of the terminal disclaimer proffered with the initial petition, which latter term is of two (2) days.

The petition is DENIED.

BACKGROUND

Application No. 07/096,207 ('207) filed September 8, 1987 was a properly filed continuing application of application No. 06/807,157 filed December 10, 1985. In due course, the '207 application received a non-final Office action mailed December 18, 1987 which set a shortened statutory period of three (3) months within which to respond. A three month extension of time under 37 CFR 1.136(a), to extend the period for response to June 18, 1987 having been obtained by the communication filed June 22, 1988 (timely by way of the certificate of mailing bearing the date of June 18, 1998), the '207 application became abandoned at midnight, June 18, 1988 by operation of 35 USC 133.

On June 18, 1988, applicant deposited papers with the U.S. Postal Service via first class mail which requested a continuation under 37 CFR 1.62 of the '207 application. As the papers were received at the PTO on June 22, 1988, that date became the filing date for application No. 07/220,882 ('882), notwithstanding the lack of copendency with the '207 case. Petitioner was informed of the

filings dates and application numbers for all the aforementioned applications by way of the filing receipt received by counsel for petitioner on or about September 22, 1988 (Exhibit A).

In due course, the '882 application gave way to application No. 07/630,365 ('365) filed under 37 CFR 1.62 on December 18, 1990, which ultimately issued as U.S. Patent No. 5,236,826 ('826) patent issued on August 17, 1993.¹ Petitioner was likewise informed of the filing dates and application numbers for all the aforementioned applications by way of a filing receipt for the '365 application. During the pendency of the '365 application, applicant noted the lack of copendency between the parent '207 and '883 applications, and filed the petition under 37 CFR 1.183 and 1.137(b) to revive the '207 application to obtain copendency with the '883 application on July 20, 1992. The accompanying terminal disclaimer disclaimed four years and one month i.e., forty nine (49) months. The petition was granted in the decision of February 17, 1993, which accepted a disclaimer of forty three (43) months of the terminal part of any patent to be granted on the application which was being revived. Moreover, the decision also required that any application claiming benefit under 35 USC 120 of the revived application had to also request that the disclaimer be recorded against the latter application. Consequently, the '826 patent, as issued, facially disclaimed its term subsequent to January 17, 2007.

A first petition under 37 CFR 1.183 was filed June 14, 1996, and was treated as petition under 37 CFR 1.182, which petition was dismissed in the decision of October 30, 1997.

The instant petition was filed February 2, 1998.

STATUTE AND REGULATION

35 USC § 253 states that:

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent.

¹Under the practice of 37 CFR 1.62, all of the above-noted files have been "bundled" into one wrapper.

disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

35 USC § 254 provides:

Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Commissioner may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Commissioner may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

35 USC § 255 states that:

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require re-examination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

37 CFR 1.182 provides that:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the

Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h).

37 CFR 1.322 provides that:

(a) A certificate of correction under 35 U.S.C. 254 may be issued at the request of the patentee or the patentee's assignee. Such certificate will not be issued at the request or suggestion of anyone not owning an interest in the patent, nor on motion of the Office, without first notifying the patentee (including any assignee of record) and affording the patentee an opportunity to be heard. When the request relates to a patent involved in an interference, the request shall comply with the requirements of this section and shall be accompanied by a motion under § 1.635.

(b) If the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form, the Commissioner may issue a corrected patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee.

37 CFR 1.321 states:

(a) A patentee owning the whole or any sectional interest in a patent may disclaim any complete claim or claims in a patent. In like manner any patentee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee and its successors or assigns. A notice of the disclaimer is published in the Official Gazette and attached to the printed copies of the specification. The disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) be signed by the patentee, or an attorney or agent of record;

(2) identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term, will be refused recordation;

(3) state the present extent of patentee's ownership interest in the patent; and

(4) be accompanied by the fee set forth in § 1.20(d).

(b) An applicant or assignee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) be signed:

(i) by the applicant, or

(ii) if there is an assignee of record of an undivided part interest, by the applicant and such assignee, or

(iii) if there is an assignee of record of the entire interest, by such assignee, or

(iv) by an attorney or agent of record;

(2) specify the portion of the term of the patent being disclaimed;

(3) state the present extent of applicant's or assignee's ownership interest in the patent to be granted; and

(4) be accompanied by the fee set forth in § 1.20(d).

(c) A terminal disclaimer, when filed to obviate a judicially created double patenting rejection in a patent application or in a reexamination proceeding, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision that any patent granted on that application or any patent subject to the reexamination

proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.

(c) A terminal disclaimer, when filed to obviate a judicially created double patenting rejection in a patent application or in a reexamination proceeding, must:

(1) Comply with the provisions of paragraphs (b) (2) through (b) (4) of this section;

(2) Be signed in accordance with paragraph (b) (1) of this section if filed in a patent application or in accordance with paragraph (a) (1) of this section if filed in a reexamination proceeding; and

(3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.

37 CFR 1.323 states that:

Whenever a mistake of a clerical or typographical nature or of minor character which was not the fault of the Office, appears in a patent and a showing is made that such mistake occurred in good faith, the Commissioner may, upon payment of the fee set forth in § 1.20(a), issue a certificate, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. A for a certificate of correction of a patent involved in an interference shall comply with the requirements of this section and shall be accompanied by a motion under § 1.635.

OPINION

Petitioner reasserts that the forty three month period currently disclaimed in the above-identified application constitutes an unjust penalty herein in light of the two days of actual hiatus in pendency in the '207 and '882 parent applications. As such, petitioner asserts, the facts of this case constitute an extraordinary situation, such that the terminal disclaimer proffered with the petition, which is limited to the two day

period of hiatus in copendency, should be accepted by the PTO in lieu of the terminal disclaimer currently of record, and a certificate of correction issued to that effect.

In actuality, since the '207 application is abandoned and, as such, has no enforceable rights, petitioner belatedly seeks to extend the term of enforcement of the '826 patent by forty three (43) months, less two days.

The showing of record fails to adequately demonstrate that the facts of this case warrant the relief(s) requested.

Petitioner appears to confuse the forty three (43) month time period application No. 07/096,207 remained abandoned before it was revived, with the two day period of time in which there was a hiatus in copendency between the '207 application, and its continuing application No. 07/220,882 filed June 22, 1998.

Petitioner's two day hiatus in copendency, nevertheless, was not remedied until the filing of a grantable petition in excess of some forty three months after that hiatus occurred.² That is, petitioner required in excess of forty three months to discover, and remedy, an error of petitioner's own making. As a prerequisite to a grantable petition, petitioner submitted a disclaimer of the time equivalent to the period of abandonment in that abandoned application, as well as in any future continuing application (which includes the instant application) which claims benefit under § 120 of the aforementioned application. Petitioner is reminded that the statutes and regulations did not compel petitioner to rely upon those early application(s) for benefit under 35 USC 120, in the instant application. However, since petitioner desires to be entitled to the potential benefits of those earlier application(s) via § 120 and specifically, the above-identified application, then petitioner must also accept the consequences attendant to that action. See Abbott Laboratories v. Novopharm Ltd., 38 USPQ2d 1309, 1312 (D.C. N. Il. 1996), aff'd 104 F.3d. 1305, 41 USPQ2d 1535 (Fed. Cir. 1997). That is, petitioner is not in a good position to urge that the forty three month loss

² It is worth noting that petitioner voluntarily initially tendered a disclaimer of four years and one month, i.e., forty nine (49) months, while the decision on petition accepted a disclaimer of but forty three (43) months. That is, while petitioner was initially willing to forego even more time (over four years) than was actually assessed, petitioner now feels that two days is reasonable under the circumstances.

of term caused by petitioner's improper filing of the successor to this application be forgiven, at the same time that petitioner simultaneously claims the benefit of the filing date of both applications under 35 USC 120. See Id.

There is no dispute that application No. 07/096,207 was abandoned for in excess of forty three months prior to its revival and the resultant establishment of copendency with application No. 07/220,882 on petition, and, as such, there is no error with respect to the period disclaimed in the recorded terminal disclaimer. Even assuming, *arguendo*, the relief(s) requested should be considered on petition, petitioner is reminded that, as a general rule, public policy does not favor the restoration to the patentee [applicant] of something that has been freely dedicated [here, forty three months of the patent term] to the public, particularly where the public interest is not protected in some manner, e.g., intervening rights in the case of a reissue patent. See Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935). Petitioner has failed to provide a reasonable, much less any, assurance that the public interest will, or can be, protected if the relief(s) requested in this petition is given favorable consideration. In this regard, an applicant's use, and Office acceptance, of a terminal disclaimer is in the public interest because such encourages the disclosure of additional developments, the earlier filing of patent applications, and the earlier expiration of patents whereby the inventions covered become freely available to the public. See In re Jentoft, 392 F.2d 633, 157 USPQ 363 (CCPA 1968).

It is brought to petitioner's attention that the principle against recapturing something that has been intentionally dedicated to the public dates back at least to Leggett v. Avery, 101 U.S. 246 (1879). In this regard, the public had almost three years since the grant of the above-identified patent to act on its facial representation that the term of the above-captioned patent will expire January 17, 2007, before the first petition was filed herein. Similarly, petitioner has had, since the submission of the aforementioned terminal disclaimer, which was proffered to secure revival for the sole purpose of obtaining copendency, no reasonable basis to expect a patent term that would extend beyond January 17, 2007. While petitioner may now consider the previously filed disclaimer to be unnecessary, or unnecessarily limiting, petitioner is, nevertheless, confronted with what has been characterized as "an unhappy circumstance", rather than a circumstance necessitating relief. See In re Jentoft, 392 F.2d 633, 639 n. 6, 157 USPQ 363, 368 n. 6 (CCPA 1968); MPEP 1490.

Petitioner had the opportunity, when the petition of July 20, 1992 was under consideration by the PTO, to request relief from the requirement for a terminal disclaimer, and/or the extent of the term disclaimed, but did not do so. Moreover, petitioner has provided no adequate explanation as to why the circumstances surrounding this patent warrant a belated consideration of this issue, some three years after the petition was granted, and the terminal disclaimer was accepted, on February 17, 1993. Equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable, due care and diligence. U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983).

The Patent and Trademark Office did not cause or contribute to petitioner's failure to properly obtain copendency, in that petitioner relied upon the certificate of mailing procedure. It is well established, and well publicized, that the certificate of mailing practice under 37 CFR 1.8 is ineffective to obtain a filing date earlier than the date of receipt of the application papers at the PTO. See Vincent v. Mossinghoff, 230 USPQ 621, 625 (D.D.C. 1985). While the PTO did contribute to petitioner's delay in realizing the true abandoned status of application No. 07/096,207 such that the aforementioned petition to revive was untimely within the meaning of (then) 37 CFR 1.137(b), such PTO contribution nevertheless, was duly considered, and resulted in the favorable decision on petition, which decision revived the '207 application such that copendency was obtained, and also required the terminal disclaimer at issue.

Petitioner's reliance on In re Wilson, 8 USPQ2d 1375 (Comm'r Pat. 1988) (requirement for a terminal disclaimer under 37 CFR 1.137(c) that would have required a loss of eleven (11) years of patent term waived due to extraordinary circumstances) in support of petitioner's request for an abbreviated terminal disclaimer is noted. However, Wilson gives no guidance as to what extraordinary circumstances therein led to waiver of the terminal disclaimer, nor does either petitioner proffer, or inspection of the instant record reveal, that any extraordinary circumstances, much less the same circumstances as in Wilson, are present and operative herein. Rather, Wilson's counsel's reasonable misinterpretation of 37 CFR 1.8 (in 1977) led to revival (not waiver) under the unavoidable standard, in Wilson. However, as noted in Vincent, supra, by 1979 the inapplicability of 37 CFR 1.8 to obtaining copendency when relying upon the date of deposit was well publicized. Still further, contrary to petitioner's assertions, the PTO was under no obligation to notify petitioner of his mistake in relying upon the

certified mailing procedure, much less research whether copendency had been obtained. Vincent, Id. While the PTO does attempt to notify parties of defective papers, it is applicant who is ultimately responsible for filing proper documents. See Id.; In re Colombo Inc., 33 USPQ2d 1530, 1531 (Comm'r Pat. 1994). Rather, as in Vincent, petitioner was provided with a filing receipt (see petition of July 20, 1992, exhibit A) that *inter alia*, correctly listed the actual filing dates for all involved applications, and furthermore, that filing receipt admonished applicant to verify the accuracy of the data thereon.

Furthermore, petitioner concededly received the filing receipt, and, as such, petitioner was put on reasonable notice of the lack of copendency well before the one year time limit of former 37 CFR 1.137 had expired. Note in this regard, that petitioner had specifically requested to extend the response period in the '207 application to June 18, 1987, and was shortly thereafter informed that the filing date of the continuing application was June 22, 1988, not June 18, 1988. Nevertheless, petitioner failed to provide the necessary (and timely) reply to the filing receipt: a petition under 37 CFR 1.137(b) to revive this application to obtain copendency. The failure to supply the proper reply was the fault of petitioner, not the PTO. As noted in Brenner v. Ebbert, 398 F.2d. 762, 765, 157 USPQ 609, 611 (D.C. Cir. 1968), cert. den. 159 USPQ 799:

The Constitution requires notice reasonably designed to forewarn against approaching default; but it does not insure against the effects of a mistaken response to timely notice knowingly received.

It follows that petitioner had received the reasonable notice required so as ensure a timely and full response to the filing receipt. That petitioner failed to timely and adequately respond was unfortunate, but such failure was avoidable by the exercise of ordinary care and diligence. See Brenner, supra. As such, had petitioner diligently filed a petition seeking to revive this application for copendency purposes under 37 CFR 1.137(b), the very terminal disclaimer that petitioner now seeks to vitiate would have been unnecessary. That is, under the terms of former 37 CFR 1.137(b), a terminal disclaimer was not required if a grantable petition to revive was filed within one year of the date of abandonment. Rather, a terminal disclaimer was only required pursuant to 37 CFR 1.183, when the one year filing period of 37 CFR 1.137(b)(4) was waived. As in Vincent, applicant's, and applicant's counsel's failure to exercise reasonable, due care and

diligence does not constitute grounds for requesting an extraordinary remedy. Lockheed, supra.

That is, that counsel (1) erroneously applied 37 CFR 1.8 in lieu of 1.10, to file an application where copendency was sought, and (2) failed to duly observe the lack of copendency expressly noted upon the subsequently issued filing receipt, does not represent circumstances that were beyond the control of petitioner, or counsel for petitioner. Rather, such circumstances could have been avoided merely by the exercise of reasonable, due care and diligence. Circumstances resulting from petitioner's, or petitioner's counsel's, failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc. 195 USPQ 586, 588 (Comm'r Pats. 1977). Moreover, even assuming that clerical inadvertence or mistake in former counsel's office caused or contributed to the asserted filing error, such is not adequate grounds for requesting extraordinary relief. See In re Kabushiki Kaisha Hitachi Seisakusho, 39 USPQ2d 1319, 1320 (Comm'r Pat. 1994) (clerical error causing delay resulting in a statutory bar does not warrant suspension of the rules).

Further in this regard, in light of the filing receipt which clearly pointed out the lack of copendency, that petitioner required some forty three months to realize that copendency had not been obtained, does not warrant PTO acceptance of a terminal disclaimer of two days. That is, as counsel for petitioner had received the filing receipt, petitioner had constructive notice of the lack of copendency. That is, notice given to applicant's representative of record constitutes notice to applicant.

Rosenberg v. Carr Fastener Co., 10 USPQ 106, 51 F.2d 1014 (2nd Cir. 1931), cert. denied, 284 U.S. 652. While counsel may have failed to properly obtain pendency, and then may have failed to note the lack of pendency, the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and petitioner is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Oellig, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987). Moreover, petitioner did not discover the lack of copendency in two days; petitioner required a time period in excess of forty three months. Thus, there is no

adequate showing of an extraordinary situation warranting the requested relief. See, Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require exceptional remedies, when a party makes an avoidable mistake in filing papers). Had petitioner duly observed the lack of copendency within two days of the actual fact, and immediately presented a petition to remedy the situation, petitioner would be in a better position to request PTO acceptance of a terminal disclaimer limited to but two days.

The Office, where it has the power to do so, should not relax the requirements of established practice in order to save an applicant from the consequence of his delay. See Ex parte Sassin, 1906 Dec. Comm'r Pat. 205, 206 (Comm'r Pat. 1906) and compare Ziegler v. Baxter v. Natta, 159 USPQ 378 379 (Comm'r Pat. 1968) and Williams v. The Five Platters, Inc., 510 F.2d 963, 184 USPQ 744 (CCPA 1975). In this regard, the established PTO practice was (1) to require, for a grantable petition under 37 CFR 1.183 and 1.137(b), a terminal disclaimer equivalent to the time period in months that the application remained abandoned, and (2) to require that the terminal disclaimer be recorded against any application claiming § 120 benefits of the application being revived.

Moreover, the PTO did not cause or contribute to petitioner's three year delay in presenting the initial petition, during which time the public has been continuously apprised that the term of the patent expires on January 17, 2007, by operation of the recorded Terminal disclaimer. Petitioner is reminded that the terminal disclaimer was then required as a condition for waiver of the one year time period of 37 CFR 1.137(b), under the authority of 37 CFR 1.183 (i.e., "subject to such other requirements as may be imposed.")³ Such does not afford proper legal or public policy grounds for requesting nullification of the terms of free

³ It is noted that, effective December 1, 1997, 37 CFR 1.137(b) was amended to delete the one year time period for filing a petition to revive thereunder, while 37 CFR 1.137(c) was also amended to require, for applications filed before June 8, 1995, the filing of a terminal disclaimer as part of a petition submitted under 37 CFR 1.137(b). The time period required to be disclaimed is equivalent to the interval starting from when the application became abandoned, and ending when a grantable petition was filed. See the final notice entitled "Changes to Patent Practice and Procedure", 62 Fed. Reg. 53132, 53160 (October 10, 1997).

dedication to the public contained in the previously filed terminal disclaimer by way of appeal, much less on petition. Cf. Ex Parte Anthony, 230 USPQ 467 (PBAI 1982) aff'd. No. 84-1357 (Fed. Cir. June 14, 1985).

The statutory authority for amendment or correction of an issued patent is found in title 35, chapter 25. The instant petition does not involve correction of a mistake by the Patent and Trademark Office (Office) (35 USC § 254) or correction of the named inventor (35 USC § 256). In addition, while the instant petition involves a disclaimer, 35 USC § 253 merely authorizes the filing and recording of disclaimers; it does not authorize the withdrawal of a terminal disclaimer. Finally, petitioner has not sought amendment or correction by reissue (35 USC §§ 251 and 252).

Unless a "mistake" is provided for in 37 CFR 1.322, 1.323, or 1.324, or affords legal grounds for reissue or for reexamination, such "mistake" will not be corrected subsequent to the issuance of an application as a patent. See 37 CFR 1.325. As stated in section 1490 of the Manual of Patent Examining Procedure (MPEP) (6th Ed., Rev. 3 1997), the mechanisms to correct a patent (i.e., certificate of correction (35 USC § 255), reissue (35 USC § 251) and reexamination (35 USC § 305)) are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer.

In any event, to withdraw the terminal disclaimer filed January 28, 1993 and properly recorded in the above-identified patent, such action must be authorized pursuant to 35 USC § 255.

A Certificate of Correction under 35 USC § 255 and 37 CFR 1.323 is available for the correction of errors of a minor or clerical character, and does not extend to the correction of errors that would constitute new matter or would require reexamination. See In re Arnott, 19 USPQ2d 1049, 1054 (Comm'r Pat. 1991); In re Hyman, 185 USPQ 441, 442 (Sol. Pat. 1975). Specifically, 35 USC § 255 requires, inter alia, that two specific and separate requirements be met prior to the issuance of a Certificate of Correction. The first requirement is that the mistake is: (1) of a clerical nature, (2) of a typographical nature, or (3) of minor character. The second requirement is that the correction must not involve changes that would: (1) constitute new matter or (2) would require reexamination. See Arnott 19 USPQ2d at 1052; see also MPEP 1490.

Apparently, the "mistake" at issue here involves petitioner's lack of inclusion in the terminal disclaimer filed January 28,

1993, of a term of two days. However, this "mistake" is not one of a clerical or typographical nature; rather correcting this "mistake" would involve a substantive change to the recorded terminal disclaimer of record. Secondly, the "broadening" of the claims of a patent, via the attempted removal of a recorded terminal disclaimer, requires reexamination (pursuant to 35 USC § 251) of the issues raised thereby. See Anthony, supra.

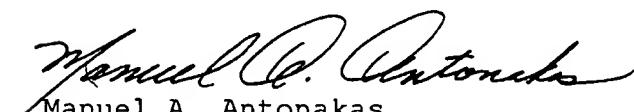
Rather, the "broadening" of the claims of a patent, via the attempted removal of a recorded terminal disclaimer, requires reexamination (pursuant to 35 USC § 251) of the issues raised thereby. See Anthony, supra. Further, in this regard, even while 35 USC § 251 is a remedial statute, and, as such, is often liberally construed, nevertheless, there is a two year bar on applying for any remedy that would effectuate broadening of an issued patent. See 35 USC 251, ¶ 4. As held in Anthony, however, removal of a recorded terminal disclaimer, and the resultant "broadening" of the vertical scope (term) of the original patent, is prohibited, *inter alia*, if the attempt via reissue is not sought within two years of the patent grant. See Id. at 470. That is, the requested nullification here, as in Anthony, of the recorded terminal disclaimer would increase the period of enforceability of the originally granted patent. It would be an improper exercise of 37 CFR 1.182 to permit petitioner to regain, on petition, what petitioner could not regain under the remedial patent statute, which, as such, is "liberally construed."

DECISION

For the reasons given above, it would be an inappropriate exercise of 37 CFR 1.182 to rescind the terminal disclaimer of record. Accordingly, the petition is granted to the extent that the previous decision has been reconsidered, but is **denied** as to rescinding the terminal disclaimer of record.

This patent file is being returned to the Files Repository.

Telephone inquiries relative to this decision should be directed to Special Projects Examiner Brian Hearn at (703) 305-1820.


Manuel A. Antonakas
Director, Office of Patent Policy Dissemination
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for Patent Policy and Projects